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No._____

Supreme Court, U.S.
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In the Supreme Court of the United States

October Term, 1985

THOMAS WALKER,

Petitioner

vs.

TIME LIFE, ETC.,

Respondents

ON PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS FOR
THE SECOND CIRCUIT

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

1.

Whether, based on the legislative history of the Copyright Act, the language: "a work 'based upon which incorporates a portion of' compared with the language "reproduced in whole or in any substantial part' places upon the plaintiff

(1) a greater burden of proof of infringement;

(2) a lesser or different burden of proof of infringement; or

(3) the same burden of proof of infringement.

2.

Whether section 106(2) of the 1976 Copyright Act created a "new" right to make so-called "derivative" works and did Congress intend a new standard to govern in light of the statutory language.

3.

Whether a judgment relying on the substantial similarity test necessarily disposes as "final" an entire claim involving derivative infringement either under the Copyright Act, the Lanham Act, or both; or must the court specifically address the "other versions" language of the statute concerning the exclusive right to prepare derivative works.

4.

In what manner may uncopyrightable elements in a work combine with an author's original contributions to form protected expression where, though some of the events depicted are true, the bulk of the work is fiction?

5.

Whether in determining infringement of either the reproduction right or the derivative right the court can refuse to consider earlier versions of a screenplay as being irrelevant on the issue of

substantial similarity; or did the Court err on that issue and prejudice the plaintiff particularly where the right to reproduce addresses only the final product and the right to prepare derivative works addresses conduct resulting in the end product?

6.

Whether the "Totality Concept" of the Harper case is a new standard to prove infringement of unpublished works based on First Amendment principles?

7.

Where a court, by omission, redrafts a statute to preclude a claim under it, and where the act complained of is a continuing wrong involving both personal and property rights in clear violation of the Acts literal terms, is such disregard of the statute usurpation?

Whether expert testimony on the issue of derivative infringement will defeat summary judgment where competing expert testimony only addresses the "Right to Reproduce" and not the additional "Right to prepare derivative works" under the relevant provision of the statute?

EDITOR'S NOTE

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OPINIONS BELOW

The January 7, 1984 opinion of the Court of Appeal is set out in Appendix A to this petition. The August 15, 1985 opinion of the United States District Court for the Southern District of New York is officially reported at 615 F. Supp. 430 and is set out in Appendix B to this petition.

JURISDICTION

This Court's jurisdiction is invoked under 28 U.S.C. section 1254(1). The filing period for obtaining a Writ of Certiorari is ninety (90) days from entry of judgement. 28 U.S.C. section 2101(c).

CONSTITUTIONAL PROVISIONS INVOLVED

Article I, section 8, clause 8 of the United States Constitution provides in pertinent part:

> "The Congress shall have the power...to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

1st Amendment

Congress shall make no law...abridging the freedom of speech, or of press.

5th Amendment

No person shall be "deprived of life, liberty, or property, without the process of law."

7th Amendment

"the right of trial by jury shall be preserved..."

14th Amendment

Nor shall any state deprive any person of life, liberty, or property, without due process of law, nor deny any person...equal protection of the laws.

STATUTES INVOLVED

The 1909 Copyright Act: 17 U.S.C. sections 1(a), 1(b), 1(c), 1(d)

The 1976 Copyright Act: 17 U.S.C. section 101 et seq., effective January 1, 1978.

INITIAL BASIS FOR JURISDICTION

Jurisdiction of the federal courts was based on 28 U.S.C. sections 1338(a) and 1338(b).

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INTRODUCTION

This case began initially as a cause of action under the common law for acts of initial infringement concerning an unpublished manuscript which acts occurred prior to the enactment of the Copyright Act of 1976. When Heywood Gould allegedly first began to adapt Fort Apache into a screenplay his acts were governed by the common law. The initial infringement began as a derivative work not under the "other versions" provision of the old Act concerning an unpublished manuscript but under the common law. Upon publication of petitioner's novel in 1976 from that point until January 1, 1978, any infringing acts committed by defendants were subsequently governed by statutory copyright law between those periods. As for infringing acts committed between 1971 and 1976 the common law protected petitioner. From 1976 to the

present petitioner no longer had rights in perpetuity by virtue of his publication entering the stream of commerce. As of 1978 petitioner has even been damaged under the present act because the initial infringement was a separate and completed wrong and the first step in a continuing course of conduct that has continued to the present date.

Here, liberally construing petitioner's complaint, it is alleged that defendants began infringing petitioner's complaint in or about late 1971 or early 1972 and have continued to do so ever since by placing in the stream of commerce various forms of the work. The final act of this unlawful course of conduct has not yet occurred. Since these acts are a continuing infringement the 1909 Act not only restricted to the author the right to copy his original writing, see 17 U.S.C.A. app. section 1(a) (West Supp. 1983), it also restricted to the copyright holder

the sole rights to prepare derivative works from a literary writing, see 17 U.S.C.A. app. section 1(b) (West Supp. 1983) ("to translate ...or make any other version thereof, if it be a literary work;..."), and to "produce, or reproduce...in any manner or by any method whatsoever" a dramatic work, see 17 U.S.C.A. app. sec. 1(d) (West Supp. 1983).

These provisions, like the new Copyright Act, give the copyright holder the exclusive right to derivative productions from his copyrighted work. See 17 U.S.C.A. app. sec. 7 (West Supp. 1983); cf. 17 U.S.C. sec. 106(2) (the 1976 Act specificity protects derivative rights). In distinguishing the right to copy from the right to prepare derivative works one commentator said: "It is that point at which the contribution of independent expression to an existing work effectively creates a new work for a different market." Goldstein, Derivative Rights and

Derivative Works in Copyright, 30 J. Copyright Soc'y U.S.A. 209, 217 (1983)

With derivative preparation rights recognized under the 1909 Act only as recently as 1976 in Gilliam v. American Broadcasting Co., 538 F.2d 14, 19-20 (2d Cir. 1976) (Videotaped programs of Monty Python skits were altered exceeding the scope of a license; even under the 1909 Act the court held that unconsented to editing of a film violated exclusive rights conferred by the Copyright Statute and that only the copyright holder had the right to make any other versions.)

Hereinafter, though petitioner refers to section 106(2) of the new Copyright Act with greater frequency then section 1(b) of the old Act he wishes to bring to this court's attention that the latter case law anticipated the provisions of the new Act. See section 1(b) (to translate...or make any other version thereof, if it be a literary work;)

Thus, in light of its evolution, copyright law can now be viewed as simply an anti-misappropriation scheme that protects the fruits of intellectual labor especially where, as in these times, the concept of Copyright has become almost completely commercialized. Indeed, a recent law review note argued that copying which amounts to reassertion of the contents of an original work for commercial gain should constitute infringement. Note, Toward a Unified Theory of Copyright Infringement for an Advanced Technological Era, 96 Harv. L. Rev. 450, 460-65 (1982). (Emphasis added)

STATEMENT

In this copyright case plaintiff Thomas Walker authored a book called "Fort Apache." In this action against Time Life Films, Inc. and others for copyright infringement and unfair competition including pendent state claims, Judge David N. Edelstein granted

summary judgment against plaintiff in the district court on the ground that the competing works were not substantially similar.

The Judge concluded that the defendants had not infringed Thomas Walker's copyright or any other rights. Screenwriter Heywood Gould had gotten his hands on his (Walker's) unpublished novel and taken the very "heart" out of his soon to be published work, and, in so doing had destroyed the derivative value of his copyright much as the Nation had done in the unconsented to printing, of Gerald Ford's memoirs. Harper and Row v. Nation Enterprises, 557 F. Supp. 1067 (S.D.N.Y 1983), rev'd 723 F.2d 195 (2d Cir. 1983), cert. granted, 104 S. Ct. 2655 (1984). Unlike the Supreme Court in Harper, the district court determined that even if the defendants had taken anything from Walker the "borrowed Material" was uncopyrightable and therefore not protectible because only

expression is copyrightable and not ideas themselves. This, in spite of Walker's submitted expert testimony highlighting and listing similarities between the works. Walker also offered evidence showing that lay observers believed the film Fort Apache, The Bronx was "derived" from Walker's book. The district court however found for the defendants because the judge believed that no reasonable observer could find the works substantially similar. Judge Edelstein, impliedly addressing the reproduction right, lost sight of the central issue of the case to which we now turn.

1. THE RIGHT TO PREPARE DERIVATIVE WORKS BELONGS EXCLUSIVELY TO THOMAS WALKER AND IS CENTRAL TO THE DERIVATIVE RIGHTS STATUTE UNDER SECTION 106(2) OF THE COPYRIGHT ACT WHICH ACT CLEARLY DEFINES A DERIVATIVE WORK UNDER

SECTION 101

An important issue in this case is whether the enactment of a new statute is relevant to what the law is. If so, then the courts are duty-bound to address the statute. Admittedly, the basis for the court's decision was the "substantiality" test under the ordinary lay observer. Judge Edelstein proceeded to "trivialize" the similarities weighing them against what he believed to be abstract and noncopyrightable elements. Never once did the judge address the relevant provision of the statute. Indeed, whether a work is derivative begins, though perhaps does not end, with the statute.

In the present case, the principal (but not the only) issue was whether Fort Apache, the Bronx constituted a derivative work under the statute. To determine this controlling issue the district court was duty bound to apply section 106(2) in conjunction with

section 101. Instead, the district court adopted the case law decided prior to the new Act as the proper formula to determine infringement. Is substantive similarity the test in spite of the Act's plain language and in spute of the ongoing and continuing infringement which acts are governed by the new Act? Should Thomas Walker be given redress for a statutory wrong based upon section 106(2) (the exclusive preparation right granted by Congress to authors), or upon section 106(1) (the exclusive reproduction right) or upon the judge-made suhstantial similarity test derived from the case law decided under the 1909 statute, the only possible alternative to the statute itself? Was the district court correct in finding the substantial similarity test under the audience test the only relevant test to prove infringement, and, if not, must the Supreme Court now decide whether the district court's order was "final: so as to

allow the decision of the Second Circuit Court to stand?

2. PLAINTIFF WALKER RELIES ON SECTION 106(2) TO IMPOSE LIABILITY INDEPENDENT OF THE ORDINARY OBSERVER TEST AS A DISTINCT SOURCE OF LIABILITY

The nature of the activity which resulted in defendants' product was never addressed by the district court. Though Walker erroneously styled his Lanham argument as being "confusingly similar" to plaintiff's work what was instinctively asserted all along was that the later work was "derived" from his novel. In reality, Plaintiff was inadvertently attempting to prove the new Copyright Act's provisions. Did the defendants base their work on his work so as to constitute a derivative work? If so, the nature of their activity in transforming the work was an

essential issue best suited to the presentation of evidence in a full trial in order to evaluate defendants' conduct in transforming the work through successive drafts in order to more clearly determine to what extent the later work depended on the former work for its own existence. Under the new Act and the doctrine of continuing infringement such reshaping does not exonerate. Whether such "reshaping" did in fact take place is normally a jury issue. It is a material triable issue of fact and can only be answered in a full evidentiary trial. Thus, defendants, by admitting access also admitted copying. Since they admit they had a copy of Fort Apache in front of them when they created Fort Apache, The Bronx, the further presumption is that they used Walker's novel in order to create their own work. The extent to which they "used" plaintiff's work thus depends on the nature of Walker's work at the time the work

was "used." We turn now to that key issue never addressed by the lower courts.

3. SINCE RESPONDENTS INITIALLY DID NOT DESIRE TO DISPUTE ACCESS, PREFERRING INSTEAD TO CONCEDE THAT RIGHT, THIS DISPUTE CONCERNS WHETHER ANY USE OF A COPYRIGHTED UNPUBLISHED WORK MAY CONSTITUTE AN INFRINGING USE.

The real question is, (access having been waived), what amount of the plaintiff's copyrighted matter in his unpublished manuscript would justify a trial on the question of infringement. Traditionally, where access is waived, the issue has always been a "fair use" question. See Shipman vs. R.K.O. Radio Pictures, 20 F. Supp. 249 (S.D.N.Y. 1937). Given the unpublished nature of the work initially at the time of Walker's alleged meeting with defendant Heywood Gould and

because unpublished works traditionally have enjoyed sweeping protection under the common law, courts have held that the common law prohibits any kind of unauthorized interference with, or use of, an unpublished work on the ground of an exclusive property right. The Supreme Court addressed this issue squarely in the recent case of Harper and Row vs. Nation Enterprises, 104 S. Ct. 2655 (1984). The high court suggested that it was the defendant's conduct which was critical in determining infringement of an unpublished manuscript. In other words, did the defendant engage in conduct that infringed any of the plaintiff's exclusive statutory rights? The Court went on to say that the right to decide when and where a work would be made public belongs exclusively to the author or to the copyright owner. Since the plaintiff in Harper had not yet published his manuscript the high court intimated that perhaps

any use that others made of it might be unfair. The right to do or to authorize " "activity" under section 106 belongs to the copyright proprietor, particularly where, as here, the process of adaptation allegedly began while Walker's manuscript was unpublished. As this court aptly stated - the period encompassing a works initiation, preparation and grooming for public consumption is crucial in any literary endeavor. Harper and Row v. Nation Enterprises, 53 LW 4566 (5-21-85).

In sum, the high court concluded that the courts should not allow certain unfair uses to defeat an author's rights in his or her unpublished work except in the most extraordinary circumstances.

4. THE FIRST AMENDMENT OF THE CONSTITUTION PROHIBITS IMPROPER FORCED AND INVOLUNTARY COMPULSORY PUBLIC SPEECH.

The freedom not to disseminate ideas publicly is as important as the right of free expression. It is the reverse side of the same coin. If I do not wish to speak publicly I may not be forced to do so. The freedom not to speak publicly serves the same end as voluntary public expression.

In the instant case if the defendants took plaintiff's ideas (as he has alleged in his complaint) and if defendants disseminated those ideas in their movie, then under the Constitution of the country such unrestrained use of another's unpublished work constitutes a "compulsory free license: which Congress has specifically prohibited. Thus, if Gerald Ford is protected constitutionally in his factual memoirs, such works traditionally being less protected than works of fancy, does it not hold equally true that plaintiff should be accorded the same equal protection of the laws?

Obviously, yes. Congress expressed no desire to limit the common law Right of first publication. Rather, in the House Report (note 10, at 62) it restated that right as one of the powers preserved under the statute.

5. ALLOWING UNFETTERED USE OF AN UNPUBLISHED WORK PROMOTES INEQUITY.

The inequity is this: the author does all the research; he drafts and styles his piece; others watchful and alert gain his confidence; and they present his concepts to the public first. If others may use the authors unpublished material for free what publisher would pay substantial sums for exclusive licensing rights? Such free use is unfair to authors in that it is financially harmful. To the extent a publisher incurs the risk that borrowers may freely use the work's core contents before publication, the publisher may be less willing to pay for

exclusive rights to the work. Movie studios may stop buying unpublished works from unknown writers if they perceive that they can gain advantages by scouting the library of Congress for an unpublished gem that might make a good film or blockbuster television series. After all, how would the unknown author ever prove access? Without access a copyright suit is guaranteed to fail. The poor author knows the value of his work. He also knows that in Hollywood where the stakes are high, his being credited with his own work is infinitismally small given the nature of greed and the unwillingness of the courts to give unknown authors their day in court. As the facts of this case illustrate, the Second Circuit pays no heed to the Supreme Court nor to the specifics of the 1976 Act. The Second Circuit still alludes to Hoeling v. Universal Studios, Inc., 618 F.2d 972 (1980) which was possibly disapproved by the high

court, but left for answer another day.

6. THE COPYING OR PARAPHRASING OF UNCOPYRIGHTABLE MATERIAL SUCH AS FACTS OR IDEAS COMMON TO BOTH WORKS CANNOT BE DISREGARDED IN EVALUATING WHETHER A SECOND AUTHOR'S USE IS EITHER INFRINGING OR AN UNFAIR COMPETITION UNDER LANHAM OR THE COMMON LAW, OR BOTH.

The Second Circuit, like the dissenting opinion in Harper, found this high court's judgement unsupportable and failed to yield to the majority. Thus, the Second Circuit would permit the defendants to extract material from a work before it is ready for presentation to the public for which it is written. Permitting such use increases the risk that the author's message will be distorted. Under the Civil Law Doctrine of Foreign Nations the author maintains the right to claim objection-

able alterations of his work including the right to control his unpublished creation. This Court's refusal to extend a fair use application to Gerald Ford's unpublished creation is a bold step in protecting an author's moral right to control his or her right of integrity. One of Congress' goals in amending the Copyright Act was to improve among other things, international dealings. The Harper case contributes to that goal. The totality concept disallows the stripping away of the uncopyrightable material because the work thus treated would all but destroy its essential character. In the last analysis a work of art is an inseparable unity. The importance of Harper is that it recognized that where ideas are concerned the selection, management, reflection and choices of an author (among a multitude of choices) are as much a part of his work as are the words chosen to express his creation. Therefore, to extract this basic core where unpublished works are

are concerned can only be considered an unfair competition and a moral wrong.

7. THE COURT BELOW IMPROPERLY DISMISSED THE LANHAM ACT CAUSE OF ACTION, AND ITS DISMISSAL WAS CLEAR ERROR.

The original complaint in this action alleged that defendants, by marketing the various works entitled Fort Apache, the Bronx, engaged unfair competition in that the defendants attempted to confuse the public into believing that its film was derived from his book in order to trade on the book's popularityand presently reasserts unfair competetition in that said works did not carry any indication that plaintiff originated the story upon which the works were based. Defendants moved to dismiss, asserting that the Lanham Act claim was deficient since it failed to show substantial similarity of the type required and dismissed on the ground that

no reasonable observer could infer from the advertisement that Fort Apache, The Bronx was derived from Fort Apache. As to the first argument, defendants' total substantive argument was but a bald assertion that the allegations were not sufficient to sustain an action. There was no citation to any authority given to support this statement, followed by a statement that plaintiff did not contend that he wrote Fort Apache, The Bronx and that accordingly, the defendants' representation was not a false designation of origin. No authority was cited.

Defendants' argument begs the question: were the book and screenplay adapted or taken from a story or literary work they got from plaintiff?

There is no question that the motion picture Fort Apache, The Bronx is a derivative work; obviously it derives from the screenplay for the same film, which in turn derives

allegedly from the book Fort Apache. Plaintiff alleged in his complaint that, further, the book and screenplay were based upon or derived from his work. Thus, by marketing various forms of Fort Apache without noting this origin, plaintiff has alleged a false designation of origin, sufficient to state a claim.

The case of Smith v. Montoro, 648 F.2d 602 (9th Cir. 1981), supports this view. There, where a plaintiff's contribution was evident in a finished motion picture, but the picture's credits failed to credit his contribution, the Court upheld the plaintiff's right to bring suit under the Lanham Act. Removal of the contributor's name from the credits constituted an express reverse palming off, and was held actionable.

In the motion picture industry, one individual may create a story or screen treatment with plot and situations spelled out,

which is assigned to another to fashion a screenplay, and to possibly still another to write a book, which may be released after, during, or before release of the motion picture. As pointed out in "Representing Writers: Motion Pictures, Television, Books and Plays" (Ziffren and Kaplan, 1978), the reputation and career of a writer is largely determined by credits:

> "His salary status depends on the quality and number of screenplays, teleplays or stories which bear his name." (Emphasis added, page 144.)

Thus, the fact that a story for a motion picture may go through several different forms before reaching the screen is not determinative of whether an unfair competition claim may be stated.

In a possible reverse passing off situation such as that presented here and in Smith, no "secondary meaning" is necessary -- and it is apparent that a defendant who

falsely designates the origin of a work as his, when in fact the origin is with plaintiff, has done that which, due to its deception of the public, obviously precludes the attachment of secondary meaning in the plaintiff. Such a defendant cannot be heard to argue that his own wrongful conduct precludes the plaintiff's stating a claim.

In short, plaintiff has alleged facts sufficient to state a claim for unfair competition (reverse passing off) under the Lanham Act. The lower courts' conclusory argument is grossly insufficient as a basis for the court's action in dismissing the claim, and this court should reverse since it was not "beyond doubt" that the plaintiff could prove no set of facts in support of his claim and given that the plots were similar, it is not "beyond doubt" that plaintiff could prove that his story was the origin of the various works entitled Fort Apache, The Bronx. The

judgment should be reversed, and the cause remanded for further proceedings as this Court deems appropriate.

REASONS FOR GRANTING THE WRIT

This case presents important questions of federal law which have not been but should be settled by this court. A question properly raised below which justifies review of the Court of Appeals' decision is the effect of Harper and Row vs. The Nation Enterprises, 104 S. Ct. 2655 (1984) on the standard to be applied in determining infringement of an author's intellectual property rights. The teachings of Harper and Row make it painfully clear that it often will be inappropriate for a court simply to declare whether competing works are substantially similar without first addressing the nature of the works involved. This Court also focused attention on the defendants' conduct and the advantage gained

from it.

Based on this Court's awareness of the communications revolution petitioner prays that the court take this opportunity to unify copyright litigation by proposing the following guidelines in all copyright litigation, none of which occurred in the instant case:

(1) That the court should read the Copyright Act literally to prohibit conduct inconsistent with the copyright holder's exclusive rights.

[(a) The holdings of the district court and the Court of Appeal in this case have done violence to a basic tenet of statutory construction, i.e., to be guided by the umambiguous language of the Act itself. Nowhere in the lower courts' decision was the fact recognized that the Copyright Revision Act of 1976 constituted a major legislative re-examination of copyright doctrine. Not once did the lower courts address the nature

of the interest at stake, i.e., was the work of the petitioner at the time it was presented to defendants a published or unpublished work, this being the key to what use, if any, may be made of the authors work. The Act specifically addresses the right to prepare derivative works and belongs exclussively to the copyright owner. In addition, this Court has taught that an infringer who mingles infringing and noninfringing elements 'must abide the consequences.' (citation omitted) particularly where as here, a section 106 exclusive right is shown. The right to prepare derivative works is one such right.

(2) The Court under the authority of sections 101 and 106(2) should have looked beyond the final version of the defendant's work not only to determine access but also to determine whether defendants violated the exclusive right to prepare derivative works. In other words, did the defendants engage in

unlawful conduct while developing their work and did they receive a substantial economic benefit in so doing which benefit persists in the end product? If so, the defendants should be held to have violated a section 106 right irrespective of the traditional substantial similarity test. Thus, if defendants either copied or based their work on a prior work in the development stages, any subsequent alterations or changes should exonerate only if the economic advantage has been eliminated. This circumvents the subsequent alteration defense relied upon by the 'movie courts' in such cases as Gethers vs. Glatty, 283 F. Supp. 383 (C.D. Calif. 1968) and Warner Brothers vs. American Broadcasting Co., 720 F.2d 231, 240 (1983), yet still prevents a copyright proprietor from inhibiting competition because of an insubstantial copyright violation.

[(b) In the instant case the Second Circuit made great note of the issue of

the substantial similarity test and that only the non-copyrightable elements of the works were similar. It believed, therefore, that it was determining fringement as a matter of law on a Motion for Summary Judgment without a trial. The phrase "as a matter of law" is very curious in light of the new copyright Act. As a matter of law, the real issue in petitioner's case is what law? Is the substantial similarity test the only relevant law on the issue of infringement, or is derivative infringement of an unpublished work the key to this case? Put in another way, was the film in question derived from petitioners book in unpublished form so as to bring into play a different infringement standard under the common law for unpublished works? Since the lower courts did not take into consideration this crucial fact it is submitted that the lower courts decisions could not have been made as a matter of fact or law. Even

under the 1909 statute the alleged unfair use of petitioners material was protectible under the standard clarified for new Act purposes but equally applicable, if not more so, for common law purposes. The facts, as alleged by petitioner, concern events that occurred in late 1971 or 1972 with defendant Gould examining the unpublished manuscript and taking notes. Therefor, as a matter of common law "any use of an unpublished manuscript incorporated as a subsequent work could constitute infringement. (See Fendler v. Morosco, 253 N.Y. 281, 291, 171 N.E. 56, 59 reh'g denied, 254 N.Y. 563, 173 N.E. 867 (N.Y. 1930) wherein it was stated that "since plaintiff had not published or produced the play, perhaps any use that others made of it might be unfair," and which was appropriately cited by this Court in Harper and Row v. The Nation Enterprises, 104 S. Ct. 2655 (1984).

3. That the Court should have

considered all relevant circumstantial evidence and not conclusively presumed that the substantial similarity test was the sole relevant evidentiary test to prove copyright infringement. Such a blatant disregard of the Court's holding in Harper and Row by the Second Circuit flies in the face of this Court's supervisory powers. By adopting the dissenting opinion the Second Circuit challenges the supreme power of the Court by presuming that the Court would be either too busy to care, or that the confrontation would slip by unnoticed. This alone presents a special and important reason for justifying review of the lower courts' decisions. In addition, review of the question whether the lower courts properly applied the unsettled rules of law regarding private works makes it painfully clear that the courts have applied the wrong rules for decades where unpublished works are concerned. Review, therefore, of the question whether the

lower courts properly analyzed the subject works to determine improper appropriation is likely to provide precedential value because the law is currently unsettled regarding the ways in which uncopyrightable elements combine with an author's original contributions to form protected expression. As the Court has noted, the absence of any admission or evidence of verbatium lifting of petitioners original language by the defendants makes for a new issue of the ways, in an apparently factual narrative, the uncopyrightable elements assemble and combine to form protected expression.

This case is the logical outgrowth of Harper and Row and the lower courts were made conspicuously aware of that fact, particularly the Court of Appeal. This Court needs to decide these issues now for delay can only wreak havoc, not upon those who would "chisel for profit" but upon the unwary author who

would not dream of the trap that has been set for him.

For the reasons set forth in this brief this Writ should be granted.

CERTIOARI SHOULD BE GRANTED TO RESOLVE A CONFLICT BETWEEN CIRCUITS

The leading case on derivative infringement has held that "deletion" and/or "alteration" of a copyrighted work is a violation of the right to prepare derivative works and confirms that substantial similarity under the audience test is not the only relevant standard where derivative works are concerned. WGN Continental Broadcasting Co. vs. United Video, Inc., 693 F.2d 622, clarified and reh'g denied 693 F.2d 628 (7th Cir. 1982). This case was one of the first to enforce the evolutionary trend which began with Gilliam vs. American Broadcasting Co., 538 F.2d 14 (2d Cir. 1976) decided under the old Act. Derivative works, though given slant attention per se under the 1909 Statute found great impact under the "other versions" language of the Old Act.

Gilliam seemed to anticipate the new Acts specific provision under section 106(2) of an author's exclusive right to prepare derivative works. Under derivative Rights the WGN court held that a work is infringed when something is "deleted" from an original work. The ruling treated "deletion" as the creation of a derivative work and hence an infringement of the author's exclusive "preparation right." The ruling by Judge Posner bears witness that "substantial similarity" as traditionally applied was neither relevant nor in issue. The Court decided that even where a license is granted to broadcast copyrighted material if the work is subsequently altered it may constitute copyright infringement.

The question needing a uniform answer is when is it appropriate to determine infringement under derivative rights and derivative works. Where do the courts begin? With the

Statute? With fair use? What about substantial similarity as applied? The language of section 106 suggest that preparing a derivative work is something quite different from substantial similarity. If the Acts language is taken literately, the defendant need not copy or even paraphrase a copyrighted work, as long as the work is used and can be seen as being "based upon" the prior work. As for substantial similarity the courts seem to be breaking away from the ordinary observer test in technical fields. In SAS Institute, Inc. vs. S&H Computer Systems, Inc., (Nos. 82-3669, 82-3670) (M.D. Tenn. March 6, 1985), programmers affiliated with S&H set out to create a "version" of the Institute's SAS program for computers other than large IBM computers for which it originally had been written. S&H misappropriated the structure and tne organizational details of the SAS and, like defendants in the instant case, argued that

ey had changed and altered its product enough
that it was no longer substantially
milar to SAS. No mind said the Court:
he copyright statute deals with human con-
ct, the nature of the activity which re-
lted in defendant's product." The Court
oked to S&H's conduct and found that the
oduct was pervasively 'based upon' SAS.

The copyright law is in some disarray.
e Third Circuit recently rejected the
dinary observer's subjective reaction as the
sue of improper appropriation. Midway
nufacturing Co. v. Bandai-America, Inc. 546
Supp. 125 (1982), recognizing that the
dience test is unworkable. Atari, Inc. vs.
rth American Phillips Consumer Electronics
rp., 672 F.2d 607 (7th Cir. 1982) recognized
e difficulty in applying the test across
fferent formats, suggesting the need for a
w test in technical fields.

Even Professor Nimmer recognized that

the ordinary observer may not be capable of detecting real appropriation without assistance or at least a critical comparison of the works. M. Nimmer, 3 Nimmer on Copyright, section 1303 [E][2] (1981), note 64.

It is clear that in examining the nation's case law there is a conflict in the circuits as to the contradiction inherent in applying the substantial similarity test where derivative works are concerned. The Ninth Circuit squarely contradicted section 106 in the case of Litchfield vs. Spielberg, 736 F.2d 1352 (9th Cir. 1984). The court dismissed as "frivolous" plaintiff's argument that an unlawful derivative work need not be substantially similar under the lay observer standard. Though plaintiff cited the Copyright Act as her authority the Court insisted that she had "cited no authority to support this novel proposition" Id. The Court seemed unreasonably critical under the circumstances, for indeed,

plaintiff had cited authority - the statute itself. On the other hand, the authority relied on by the Ninth Circuit in support of its own position, Harry Fox Agency, Inc. v. Mills Music, Inc., 543 F. Supp., 844, 849 (S.D.N.Y. 1982), rev'd on other grounds, 720 F.2d 733 (2d Cir. 1983) cert. granted, 104 S. Ct. 1676 (1984), appears not to be on point. The page that the court cited from the Harry Fox district court opinion stated that "[a] work is a derivative work if it is substantially derived from an underlying work." (emphasis supplied). It does not state or "suggest" as the court contends that "a work is not derivative unless it has been substantially copied from the prior work." Litchfield, 736 F.2d at 1357 (emphasis added). In fact, none of the cases cited by the Ninth Circuit were on point particularly where the court directed attention to a definition of a derivative work created by

Professor Nimmer and put forth in his 1963 treatise on copyright. The Second Circuit, however, did use the "substantially copied" language in Reyher v. Children's Television Workshop, 533 F.2d 87, 90, Cert. denied, 429 U.S. 980 (1976), borrowed from Nimmer. Happily, the Congress in 1976 did not adopt Professor Nimmer's definition. Whereas Nimmer saw no distinction between the right to copy and the right to prepare derivative works, Congress explicitly did. The Act makes it clear that an infringement under section 106(1) may not necessarily infringe section 106(2) and vice versa. If a work is "copied" it is not a derivative work. If a work is derivative it is not necessarily a copy. But there is a difference between the two; and that is what this case is all about.

CONCLUSION

The most obvious reason for concluding

that Congress said what it meant, and that judicial disregard for derivative infringement would be unjustified, is that the term "derivative work," defined in the Act, is used in other provisions of the statute. Generally, statutory definitions of words used elsewhere in the same statute furnish official and authoritative evidence of the legislative intent. C. Sands, Statutes and Statutory Construction (1972), 4th ed. (rev. ed. of Sutherland's Statutory Construction), section 27.01, 27.02; see Walling v. Portland-Terminal Co., 330 U.S. 148, 130-51 (1946). A definition which declares what a term means excludes any meaning that is not stated. Id. Thus, had Congress intended to limit the definition of a derivative work to works which are substantially copied from other works, it would have done so. The absence of such a limitation indicates that it could have done so, but instead chose not to. Thus, any changes

or "preparation" that affords an altered work a separate new copyright is significantly a derivative work and, where, as here such conduct is unconsented to, such derivative work version would constitute copyright infringement.

For all the reasons set forth in this petition, the Writ of Certiorari should be granted.

Dated: April 4, 1986

Ralph Francis Server

RALPH FRANCIS SERVER

Harlan Arnold

HARLAN ARNOLD
(Attorney of Record)

ATTORNEYS FOR PETITION
THOMAS WALKER

Annexed:

"A" Second Circuit Opinion - filed Jan. 7, 1986

"B" District Court opinion - filed Aug. 15, 1985

ADDENDUM: A FINAL WORD ON EXPERT TESTIMONY

PLAINTIFF'S EXPERT ADDRESSED THE ISSUE OF WALKER'S EXCLUSIVE RIGHT TO PREPARE DERIVATIVE WORKS WHICH "TRANSFORMED" HIS WORK AND "RECAST" IT FOR MOTION PICTURE PURPOSES-WHEREAS THE COURT ADDRESSED ONLY THE "RIGHT TO COPY" THUS DISREGARDING THE MOST CENTRAL ISSUE IN THE CASE - THE ALTERNATIVE RIGHT TO PREPARE DERIVATIVE WORKS.

Expert Samuel Rosenberg in his testimony spoke of the method known to everyone in the film industry as the "old switchero" technique which word was taken from an ancient con-game in which worthless paper is "switched" to substitute for genuine paper currency. He had the following to say:..."In the motion picture industry the term "switcheroo" is used to describe the process whereby unscrupulous producers or writers take someone else's valuable literary or film property

and transforms it in whole or part so that they can offer it as property they have created from scratch. In this widespread practice which has been the cause of a lot of litigation, the major desirable qualities are kept but changed by means of the reversal or juggling of names, physical attributes, local or change of motnation.

18. In the instant case the "switcheroo" is so extensive that it suggests the following analogy:

A family "A" goes on a long vacation abroad leaving the house they built and occupied for many years, unoccupied. When they return they find that in their absence a stranger has moved in kept some of the best pieces of furniture, thrown out the rest, remodelled the interior and exterior and painted the walls in bright colors, different from those originally there. The usurper (B) has also put erotic pictures

on the walls and erected a false facade to the front of the house. However, the house, the lot, the foundation, the unique neighborhood and its inhabitants remain un changed as "as" property. When ordered to leave the premises, the usurper B says calmly "how can you say this is your house? Look at all the improvements and changes I have made - my taste in architecture and furnishings is commercially superior. I have enhanced the property's value so much. If you don't like it, take me to Court and sue me I will prove that I deserve the property more than you do because of my improvements.

19. If the above analogy of a "house" (reads "Stationhouse") seems irrelevant or immaterial (or illogical), I offer as the source of the analogy revealing the plagiarism method called "switcheroo" or dishonest transformation a most revealing statement made by Mr. Stade on page 14 of

his affidavit to wit: "24. If I saw a film of Heywood Gould writing his script with Plaintiff's elusive first script before him, I would still say that the Plaintiff had no case for copying against Gould. The book and movie are so different, in detail and overall conceptions that I would simply have to congratulate Mr. Gould on the transformation and improving power of his imagination". In this amazing statement Mr. Stade has inadvertently pointed the finger of guilt at Heywood Gould and in fact corroborated the intent and meaning of the above "Analogy" of a "house owner" (read station house-owner") named Tom Walker who has heen dispossessed by a usurper named Time-Life-Inc. Mr. Stades statement suggests that the motion picture Fort Apache, The Bronx is a deliberate transformation of Tom Walker's book Fort Apache Through juggled and "improved" and transformed cosmetically it is still the same police station in the same New York neighborhood with the same basic leading character, with the same high idealistic

philosophy. Though it wears cleverly designed masks, the defendant's motion picture is a "house illegally occupied and transformed by an unconscienable usurper."

20. As a glaring and highly crucial example of Mr. Stade's apparent ignorance of the way the widely used method called "Switcheroo" works in actual practice his comments on plaintiff's charge that the Time Life Writer Heywood Gould took the incident of "someone being murdered by being thrown off a slum roof top by two utterly ruthless male perpertrators" In the following excerpt from Stade's affidavit I find him once again unwittingly exposing the transformation (switching) tactic of his client Gould:

"In the incident in which two fourteen year old boys throw another off a roof, Walker presides at the boy's rescue and the father of one of the perpetrators angrily

claims that the arrest of his son was a racial issue. This incident is brief and poses no moral dilemma - it is merely one of the scores of similar sad and violent incidents that the book gives"

Mr. Stade concludes: 43. "There is simply no similarity between this incident and the one in the movie in which two cops throw a young man off a roof to his death. A viewer of the movie who forgets everything else will remember this scene, which is crucial to the film's plot and moral issue as a whole; it has the repercussions for many characters and primarily for Murphy, the cop." The defendant Heywood Gould did add all this to the "House" ("Station House") which was built by the Plaintiff Walker who despite the addition owns it as a literary property and despite the incessant effort the house illegally occupied by Time-Life cannot be considered its own but the "house" it built upon anothers foundation

and lot.

21. The major theme overshadowing all others in the Plaintiff's book Fort Apache and the Defendant's movie Fort Apache, The Bronx may be described as: The legend or story of the heroes forgotten and abandoned to suffer in a man-made hell-on-earth, but which they both survive morally and physically". Stripped of their superfluities and cosmetic overlays, especially those of the movie screenplay written by defendant Gould we find that the two properties have the same central character the hero (call him Walker or Murphy) is, in composite, an Irish-American belonging to a family that has, for several generations served New York City in the capacity of Police Officer.

22. The Affiant Stade's affidavit states airily that New York City's Police Force has many similar "Irish cops" who are third generation cops. In response

Tom Walker has stated quote" I have never heard of any other New York Police Officer who has had that family history of service I challenge Gould to name even one such officer".

23. The similarity between the book's Walker and the Movie's Murphy is most impressive and interesting. In both narratives we find the unique situation in which a good even idealistic man is assigned to the worst, most dangerous, least rewarding Police District in New York City the sociological inferno in the South Bronx called "Fort Apache" Although there are many cities in the world where conditions are as bad or worse than the South Bronx one fact remains which cannot be ignored. Both heroes under discussion here act out their secular "stations of the cross in the same stationhouse in the same Police District and in the same city. In both properties the composite hero

learns at once that he has been literally thrown to the wolves in a human jungle where, to qyote from the Plaintiff's book (page 66) "You've seen it all happen: people by the thousands dying, shot, stabbed, beaten, poisoned, pushed, raped, run over, robbed and saddest of all forgotten. Our composite heroes (Walker and Murphy) find that they have been abandoned and, like the people of their district, completely forgotten by the outside world that created the sociological conditions of the dreadful South Bronx.

24. Left to cope with the insoluble social catastrophe with inadequate training and physical resources this compassionate even idealistic police hero strives mightily to understand and emphathise as best he can with the suffering people in his precinct who hate him and try to kill his comrades and himself at every chance they get. The hero struggles to overcome all the hatred and crime with good deeds. He is

an honest Police Officer. Both heroes described in the respective narratives do manage to survive both morally and physically unlike similar heroes in other movies and books who are murdered or commit suicides as in Joseph Wambaugh's book and movie the Blue Knight.

25. In all major human and occupational respects, plaintiff's hero and defendant's hero are one and the same. They are identical and I set out hereunder for the Court's convenience the flagrantly visible similarities which I have drawn from my own reading and from Tom Walker's impressive list of similarities between his book and the motion picture based on his book?

WALKER'S BOOK	TIME-LIFE MOVIE
1. A cop in patrol car holds a book, another cop tells him to read a better book.	1. A cop in a patrol car holds a book. A fellow cop tells him to read a different one.

2. A pimp offers Walker a bribe, which Walker angrily refuses. He does not arrest the pimp for attempted bribery.	2. A pimp offers Murphy a bribe, but though Murphy angrily refuses the bribe, he doesn't arrest the pimp for attempted bribery.
3. On first day of duty, Walker takes knife from emotionally disturbed man, the crowd of onlookers applauds his bravery and skill in doing so.	3. Murphy takes a knife from violently disturbed man. The crowd of onlookers applauds his skill and bravery in doing so.
4. Upon his arrival on first day of duty at Fort Apache, keeps Indian equipment: Bow, Arrow, and Wig in his stationhouse desk.	4. Upon his arrival for duty at Fort Apache the new captain (Asner) is annoyed to see indian paraphernalia hanging on the walls of stationhouse.
5. Walker is a fourth generation Police Officer.	5. Murphy is a third generation police officer. (See above for refutation of this example of copying.)
6. Fort Apache is described as the very worst assignment in New York City for any policeman: "It is the department purgatory".	6. Fort Apache is called the very worst assignment for any police officer. It is called the Department's "Siberia".

7. Upon his first arrival at his new assignment at Fort Apache, Walker the new lieutenant Walker cannot find a parking place.	7. Upon his first arrival at Fort Apache, the new captain (Asner) cannot find a parking place.
8. On his first day of duty at Fort Apache, Walker runs after a perpetrator, fails to catch him and is breathless.	8. On Asner first day of duty at Fort Apache, Murphy runs after a felon but fails to catch him.
9. Upon arrival for duty in his first day at Fort Apache he sees the very poor morale and discipline and resolves to improve it.	9. Upon his first day duty at Fort Apache the new captain sees the very poor morale and discipline and resolves to improve it.
10. Within minutes of his arrival on his first day at Fort Apache Walker is told that a white cop and a black cop were murdered in their patrol car by ten bullets fired at close range from a handgun.	10. Within minutes of his first arrival at Fort Apache, the new captain (Asner) is told that a white cop and a black cop have been murdered in their patrol car by six bullets fired from a handgun at close range.
11. Walker is profoundly upset by the news of the Senseless cop killing.	11. Murphy is also affected in the same manner as Walker.

12. Upon arrival at Fort Apache for duty on his first day, Walker meets a disgruntled desk sergeant.	12. Upon his arrival at Fort Apache, the new captain (Asner) meets and talks with a disgruntled desk sergeant.
13. Upon arrival on first day at Fort Apache, Walker is given briefing on the deplorable neighborhood; and manpower available for dealing with the insuperable task.	13. Upon arrival at Fort Apache, the new captain (Asner) is given a through briefing exactly like that given to walker on his first day of duty.
14. Walker mentions the inadequacy of computers for dealing with the terrific problems in Fort Apache and its neighborhood.	14. The new captain (Asner) speaks of the computer's inadequacy in dealing with insuperable tasks of his command and of the South Bronx.
15. On his first day at Fort Apache Walker meets an old Jewish man who is very friendly and helpful. The man, Sid Brown, takes him on a tour of the South Bronx.	15. On his first day of duty, the new captain, (Asner) meets a Jewish man who is most helpful and who takes him on a tour of the South Bronx. The man is named "Dworkin."
16. On his first day at Fort Apache	16. On his first day at Fort Apache,

Walker learns of a motorist from Westchester County, New York (no particular locale mentioned) who wandered into Fort Apache Territory, he was killed and his car destroyed.

the new captain (Asner) learns of a motorist from Westchester County who wanders into Fort Apache territory. He is shot and his car is destroyed. The Westchester locale is not named.

EXPERT TESTIMONY ACCOMPANIED BY UNDERLYING FACTS MAY DEFEAT SUMMARY JUDGMENT IF IT APPEARS THE AFFIANT IS COMPETENT TO GIVE AN EXPERT OPINION AND ADDRESSES THE RELEVANT ISSUE - THE RIGHT TO PREPARE DERIVATIVE WORKS

Samuel Rosenberg, for 35 years an expert in the motion picture industry, explained on what basis he formed his opinion. He described in detail how he arrived at his conclusions. Whereas defendants' expert addresses "copying" plaintiff's expert addressed "derivation." Defendants' expert (Joint Appendix at 385) stated adamantly that "earlier version of the movie script which were changed were irrelevant because they were changed in the final version. He consistently argued that even if derivation existed it did not matter (J.A. at 388) "what counts," he said, "is the finished product..." He concluded by saying:

"the plain fact is that these are two vastly different works," apparently believing that wide departures from the original are enough to disprove infringement. This is error.

In the recent case of Indian Coffee Corp. v. Proctor & Gamble Co, 752 F.2d 891 (1985), the Third Circuit ruled that as regards expert testimony in technical fields it is the opinion of the relevant community which controls as to whether the basis of expert testimony is sufficiently reliable under F.R.E. 703. The Court concluded that the district court must make a "factual inquiry and finding as to what experts in the field find reliable" and that the district court "could not substitute its own judgment for that of the expert." No less is required in this case. Sid and Marty Krofft v. McDonald's highlighted the extrinsic/intrinsic distinction in order to determine objective similarity of idea as a barometer of liability. By so doing the Court sought to restrict the Court and expand

the domain of the trier of fact. 3 M. Nimmer at 13.03 [E][8] Krofft, was an attempt at objectivity in copyright matter which limited discretion to disregard relevant expert testimony thereby putting the ONUS on the party opposing expert testimony and on the district court to decide the sufficiency of an affidavit for Summary judgment purposes, particularly where, as here, the expert has backed up his opinion not only with specific facts but with the relevant statute.

It is clear that the courts below found for the defendants based on the substantial similarity test only and ignored plaintiff's testimony regarding the exclusive right to "transform" or "recast" his work for a new market. The declaration of Samuel Rosenberg was sufficient to create an issue of disputed fact on a genuine material issue predicated upon the existence of an asserted and viable legal theory entitling plaintiff to judgment as a matter of law. Bushie v. Stenocord Corp., 460 F.2d 116.

AFFIDAVIT OF MAILING

I, Harlan Arnold, a member of the Bar of the Supreme Court of the United States and counsel of record for Ted Berkic, petitioner herein, hereby certify that on April 7, 1985, pursuant to Rule 33, Rules of the Supreme Court, I served three (3) copies of the foregoing Petition for Writ of Certiorari on the respondents herein by depositing such copies in the United States Post Office, Beverly Hills, California, with first class postage prepaid, properly addressed to the Post Office address of Patterson, Belknap, Webb & Tyler, Attorneys for Defendants-Appellees, 30 Rockefeller Plaza New York, New York 10112.

All parties required to be served have been served.

Dated: April 4, 1986

HARLAN ARNOLD
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APPENDIX

UNITED STATES COURT OF APPEALS

FOR THE SECOND CIRCUIT

No. 518—August Term, 1985

Argued: November 20, 1985 Decided: January 7, 1986

Docket No. 85-7690

THOMAS WALKER,

Plaintiff-Appellant,

—against—

TIME LIFE FILMS, INC., DAVID SUSSKIND, GILL CHAMPION, MARTIN RICHARDS and HEYWOOD GOULD,

Defendants-Appellees.

Before:

FEINBERG, *Chief Judge*,
LUMBARD AND OAKES, *Circuit Judges*.

Appeal from order of the United States District Court for the Southern District of New York, Edelstein, J.,

granting defendants' motion for summary judgment in copyright infringement case on grounds that works were not substantially similar in their copyrightable aspects and that plaintiff could not establish "passing off" under Lanham Act, and dismissing on the merits pendent state law claims.

Affirmed.

JIMMIE L. ENGRAM, New York, NY, *for Plaintiff-Appellant.*

EUGENE L. GIRDEN, New York, NY (Patterson, Belknap, Webb & Tyler, Blair Axel, of Counsel), *for Defendants-Appellees.*

FEINBERG, *Chief Judge*:

Plaintiff Thomas Walker, author of the book "Fort Apache," appeals from an order of the United States District Court for the Southern District of New York, David N. Edelstein, J., granting summary judgment for defendants in plaintiff's copyright action against Time Life Films, Inc., David Susskind, Gill Champion and Martin Richards, producers of the film "Fort Apache: The Bronx," and Heywood Gould, the film's screenwriter. The district court held as a matter of law that the book and the film were not substantially similar in their copyrightable aspects. Appellant argues that substantial similarity remained a genuine factual issue, and contends that the district court made several evidentiary errors in

comparing the two works. We conclude that no reasonable observer could find substantial similarity between the protectible elements of plaintiff's book and defendants' movie, and that the district court did not abuse its discretion in its other rulings. Accordingly, we affirm.

I.

This litigation arises out of two works depicting the violence and urban decay of the 41st Precinct of the New York City Police Department. The 41st Precinct, located in the South Bronx, has been known among police officers by the nickname "Fort Apache" since the late 1960's for its high incidence of violent crime, which has drawn the attention of the press and other news media. Appellant Walker, a former New York City police officer, was assigned there as a lieutenant from May 1971 until August 1972. Based upon his experiences, he wrote a book entitled "Fort Apache," published in 1976 in hardcover and in paperback, which sold in excess of 100,000 copies.

As its author describes it, "Fort Apache" is a chronicle of true events. Narrated by Walker, it begins on his first day at the precinct station house, where he is shocked by its squalor, an attack on the station house by an angry mob, and the apparent inability of the police to maintain its security. On his first day, he also witnesses several violent crimes, and notes that much of the area's housing is ruined or dilapidated. Successive chapters give Walker's harrowing impressions of dozens of ugly and sometimes bizarre murders, suicides, robberies and other crimes, as well as of the drug-dealing, prostitution and physical devastation that characterize the neighborhood. Through his accounts, he illustrates some of the social patterns of

the South Bronx, including family life and the popularity of youth gangs. Through anecdotes, the book also illustrates the morale of the precinct's officers and the ways they respond to the stresses of their work.

The book unfolds as a chronicle of police work and daily life in a violent neighborhood. Several chapters focus on specific topics, such as attacks on policemen. Throughout the book, Walker expresses compassion for those he considers the victims of the South Bronx, hopelessness regarding the prospects for basic improvement there, and a sense that the officers of the 41st Precinct will continue to fight a rearguard action against lawlessness with very limited success. The book ends with his transfer to another precinct.

Defendants produced and wrote the screenplay for the film entitled "Fort Apache: The Bronx," which is set in the same milieu as plaintiff's book. In 1973, Heywood Gould made a contract with the newly formed Fort Apache Company to write a screenplay for a film set in the South Bronx. The following year, the Company filed a draft screenplay written by Gould with the United States Copyright Office. In 1976, defendants placed an advertisement in the trade journal "Variety" announcing the production of a film. "Fort Apache: The Bronx" was released in 1981.

The movie focuses on Connolly, the newly arrived captain of the 41st Precinct, and Murphy, a rank-and-file veteran of 12 years there, and their responses to the crime and decay of the South Bronx. The film also portrays the close, unique of Murphy and his partner, Corelli. The film opens with the motiveless murder of two rookie policemen by a deranged prostitute. Much of the film

shows the extensive, finally unsuccessful efforts of the police to locate the killer. The prostitute, in the meantime, is rescued by Murphy from a beating by her pimp, and thereafter murders another man. While engaged in the search, Murphy and Corelli respond to a bewildering variety of other South Bronx characters, crises and crimes, including a fleet-footed mugger, the birth of a child to a teenage mother and mob attacks on firefighters and policemen. The film centers around Murphy's affair with a drug-addicted nurse, who eventually is killed by drug dealers trafficking in narcotics at the hospital where she works. In addition, Murphy and Corelli witness the murder of a Hispanic teenager by fellow officers who throw the boy off a roof. After agonizing over whether to denounce the officers, Murphy does so against the advice of the nurse and Corelli, but tenders his resignation to Connolly at the same time. Connolly, however, asks Murphy to reconsider. Meanwhile, the drug dealers, who have given the nurse a fatal overdose, barricade themselves with hostages in the hospital. At the movie's climax, Murphy rescues the hostages. He then succeeds in catching the mugger, displaying a pride in his work that implies he will return to his job.

Walker contends that defendants infringed upon his copyright by copying from the manuscript for his book. He claims that Heywood Gould, then a reporter, met Walker on a visit in late 1971 or early 1972 to the 41st Precinct, and learned that Walker was working on a book. Walker then, he says, showed Gould the manuscript on the condition that Gould not take notes on it. Gould, however, examined the manuscript for several hours and took notes. Shortly thereafter, the manuscript disappeared from the station house. Gould denies ever

having met Walker or read any version of his book, and contends that he received the idea for the screenplay from news reports describing a crime in the area and from two other officers.

In 1980, while defendants' film was still in production, Walker sued defendants in New York state court for infringement, common law copyright, fraud, conversion, unfair competition and conspiracy to commit fraud. The New York Supreme Court dismissed the infringement claim on the ground that the federal courts had exclusive jurisdiction over copyright actions. Holding that Walker's other legal theories merely duplicated his infringement claim, the court dismissed the entire action for lack of jurisdiction. Walker v. Time Life Films, Inc., No. 8938/80 (N.Y. Sup. Ct. 1983).

Subsequently, Walker brought this action in federal court under 28 U.S.C. § 1338(a), alleging copyright infringement. Lanham Act violations, unfair competition and breach of a confidential and fiduciary relationship. No demand was made for a jury trial. After the parties agreed to a pre-trial order incorporating stipulated facts, defendants moved for summary judgment. Defendants conceded for the purpose of their motion that Gould had had access to Walker's manuscript, but argued that the book and the film were so different that no reasonable trier of fact could find them substantially similar under the copyright laws. In support of this argument, defendants offered affidavits, some of which were prepared by an expert in literary analysis, analyzing and comparing the structure, mood, characters, themes and episodes of the two works. In response, Walker also submitted affidavits by an expert, highlighting and listing similarities between the works. In addition, Walker offered documen-

tary evidence purportedly showing that lay observers believed the film to be derived from the book, as well as a videotape of the film, with voiceovers drawing attention to similar events or passages in the book and the first portion of the film (the voiceover version).

After reading the book and viewing the movie, and considering the experts' affidavits, Judge Edelstein granted defendants' motion. The judge rejected the claim of infringement because no reasonable observer could find the works substantially similar, and whatever similarities existed were trivial, abstract or related to non-copyrightable material. The judge refused, however, to view the voiceover version or to compare the works on the basis of Walker's proffered lists of similarities. Concluding that the movie and the book were not confusingly similar and that defendants had not attempted to "pass off" the film as derived from the book, the court granted summary judgment on the Lanham Act claim, and found the pendent state law claims barred for failure to state a cause of action and preempted by the copyright laws. Accordingly, the judge dismissed the entire complaint on the merits in a well-reasoned opinion, reported at 615 F. Supp. 430. This appeal followed.

II.

It is undisputed that appellant Walker has a valid copyright in his book. To prove infringement, he must also show copying by defendants. Warner Brothers v. American Broadcasting Co., 654 F.2d 204, 207 (2d Cir. 1981) (Warner I). Copying may be inferred where a plaintiff establishes that the defendant had access to the copyrighted work and that substantial similarities exist as

to protectible material in the two works. Reyher v. Children's Television Workshop, 533 F.2d 87, 90 (2d Cir.), cert. denied, 429 U.S. 980 (1976). Put another way, Walker must show that his book was "copied," by proving access and substantial similarity between the works, and also show that his expression was "improperly appropriated," by proving that the similarities relate to copyrightable material. Hoehling v. Universal City Studios, Inc., 618 F.2d 972, 977 (2d Cir.), cert. denied, 449 U.S. 841 (1980); Arnstein v. Porter, 154 F.2d 464, 468 (2d Cir. 1946); Davis v. United Artists, Inc., 547 F. Supp. 722, 723 (S.D.N.Y. 1982).

A. *General Claims of Similarity.*

In moving for summary judgment, defendants conceded access to Walker's manuscript, thus narrowing the issues to the similarity between the works. In response, Walker argued that "Fort Apache" and "Fort Apache: The Bronx" were similar in plot, theme, dialogue, mood, setting, pace and sequence. He now asserts that these parallels, akin to what the late Professor Nimmer termed "comprehensive nonliteral similarity," 3 Nimmer on Copyright § 13.03 [A][1] (1985) (hereinafter Nimmer), raised questions of fact that could not be resolved on a motion for summary judgment. However, a district court may determine noninfringement as a matter of law on a motion for summary judgment either when the similarity concerns only noncopyrightable elements of plaintiff work, or when no reasonable trier of fact could find the works substantially similar. Warner Brothers v. American Broadcasting Co., 720 F.2d 231, 240 (1983) (Warner II). To determine whether the grant of summary judgment was proper, we must decide whether the lack of substan-

tial similarity between the protectible aspects of the works was "so clear as to fall outside the range of disputed fact questions" requiring resolution at trial. Id. at 239.

The copyright protection granted to appellant's book extends only to its particular expression of ideas, not to the ideas themselves, 17 U.S.C. § 102(b), a distinction easier to state than to apply. In assessing claims of substantial similarity, courts therefore must decide "whether the similarities shared by the works are something more than mere generalized idea or themes," Warner I, supra, 654 F.2d at 208, a task generally performed after detailed examination of the works themselves, see, e.g., Sheldon v. Metro-Goldwyn Pictures Corp., 81 F.2d 49 (2d Cir.), cert. denied, 298 U.S. 669 (1936). Judge Learned Hand articulated this distinction in his often-quoted "abstractions" test:

> Upon any work, . . . a great number of patterns of increasing generality will fit equally well, as more and more of the incident is left out. The last may perhaps be no more than the most general statement of what the [work] is about, and at times consist only of its title; but there is a point in this series of abstractions where they are no longer protected . . . .

Nichols v. Universal Picture Corp., 45 F.2d 119, 121 (2d Cir.), cert. denied, 282 U.S. 902 (1931).

Each of the panel members has read the book and viewed the film. Applying these principles to appellant's claim that the film replicates the fundamental structure, setting and pace of his book, we conclude from a comparison of the two works that no reasonable observer could find them substantially similar beyond the level of

generalized or otherwise nonprotectible ideas. We note at the outset that Walker's book, by Walker's own description, is an account of actual events. This renders proof of infringement more difficult, because copyright protection in this circuit does not extend to facts or to true events, even if they are discovered through original research. Appellees therefore were free to avail themselves of any facts contained in Walker's book, see Hoehling, supra, 618 F.2d at 979-80, so long as they did not appropriate his unique expression of those facts.

At the most general level, the movie and the book tell the same story. Both recount the experiences of policemen battling the hostile environment of the 41st Precinct. But, in moving to the next level of specificity, differences in plot and structure far outweigh this general likeness. "Fort Apache: The Bronx" is intensely plotted. Much of the work is dedicated to several vivid, interrelated story lines. Throughout the film the police engage in an extensive manhunt for the killer of their fellow officers, making mass arrests and sweeping the South Bronx for leads. Murphy begins a love affair that first blossoms, but ends tragically. He experiences moral doubts, which he eventually resolves, in deciding whether to testify against fellow officers who have committed a crime. Connolly struggles, with sometimes unfortunate consequences, to transform the precinct and the station house into an orderly "house of law" enjoying the respect of the area's residents. The book, on the other hand, is organized topically, moves anecdotally from one event to another, and has little plot or story line. As a nonstop recounting of brutal crimes and police action, it achieves its effects by creating a depressing, somewhat impressionistic, cumulative portrait of life in a crime-ridden and poverty-stricken urban neighborhood.

Thus, the works differ radically in pace and dramatic structure. The story lines of "Fort Apache: The Bronx" impart a continuity and suspense entirely missing from the book. In the film, each subplot and set of characters also relates to all the others. For example, the drug dealers who traffic in narcotics at the hospital first appear as targets of an undercover investigation. Later, they encounter the deranged prostitute who, unknown to them, has killed the two police officers in the movie's opening scenes. She attempts unsuccessfully to kill one of the two dealers as well, and he stabs her fatally. The dealers next discover that the drug-addicted nurse is Murphy's lover, and, fearing that she will expose their operation, decide to kill her by selling her pure heroin. After carrying out their plan, they are caught selling narcotics in the hospital and barricade themselves in a room there, taking doctors and nurses as hostages. Murphy, believing that the nurse is in the room, leads a bloody rescue of the hostages. On finding that the nurse is not among them, he rushes to find her, only to be confronted by the sight of her dead body in the emergency room. The book contains no such plot intricacies. Rather, diary-like, it presents a series of randomly-ordered sketches of police life and work, without significant character or plot development. Although individual vignettes sometimes carry suspense, no continuing story emerges to engage the reader's attention.

To be sure, the book and the film share an identical setting, and police officers are central characters in both works. But the South Bronx and the 41st Precinct are real places known to the public through media reportage. Accordingly, the notion of telling a police story that takes place there cannot be copyrightable. As to Walker's claim that the film misappropriates characters from his book,

we must consider the "totality of [their] attributes and traits" as well as the extent to which the defendants' characters capture the "total concept and feel" of figures in the book. Warner II, supra, 720 F.2d at 241. The characters of "Fort Apache: The Bronx," however, are quite different from those in the book. In the film, Murphy is an independent-minded, cynical, divorced patrolman contemptuous of authority, once demoted for insubordination. Murphy's romantic scenes reveal tenderness; his soul-searching over whether to denounce fellow officers reveal both integrity and loyalty. By contrast, his boss, Captain Connolly, is a hard-driving disciplinarian eager to "go by the book" and establish the rule of law in the South Bronx. Walker, the book's narrator, is a pragmatic, happily-married lieutenant who never disobeys an order or questions his superiors. In his life history, outlook, rank and marital status he bears little resemblance to any of the film's characters.

B. *Specific Claims of Similarity:*

In the district court, appellant proffered lists of specific alleged similarities in an attempt to prove, in Professor Nimmer's term, "fragmented literal similarity" between the book and the film. 3 Nimmer, supra, § 13.03[A][2]. None of these claims alters our conclusion that the district court properly held that as a matter of law no substantial similarity exists between the protectible elements of the works. For example, appellant notes that both the book and the film begin with the murder of a black and a white policeman with a handgun at close range; both depict cockfights, drunks, stripped cars, prostitutes and rats; both feature as central characters third- or fourth-generation Irish policemen who live in Queens and frequently

drink; both show disgruntled, demoralized police officers and unsuccessful foot chases of fleeing criminals.

These similarities, however, relate to uncopyrightable material. The killing of the two police officers actually occurred and was reported in the news media, which placed the historical fact of the murders in the public domain and beyond the scope of copyright protection. Hoehling, supra, 618 F.2d at 978-79. Elements such as drunks, prostitutes, vermin and derelict cars would appear in any realistic work about the work of policemen in the South Bronx. These similarities therefore are unprotectible as "scenes a faire," that is, scenes that necessarily result from the choice of a setting or situation. See Reyher, supra, 533 F.2d at 92. Neither does copyright protection extend to copyright or "stock" themes commonly linked to a particular genre. Foot chases and the morale problems of policemen, not to mention the familiar figure of the Irish cop, are venerable and often-recurring themes of police fiction. As such, they are not copyrightable except to the extent they are given unique—and therefore protectible—expression in an original creation.

Appellant lists other events claimed to occur in both works. Leaving aside the difficulty of comparing unified artistic works on the basis of such scattered analogies, we find that when the works are examined the claimed similarities either fail to materialize or prove entirely insubstantial. Appellant correctly notes, for instance, that in both works a person is thrown off a roof. But the differences between the two incidents are overwhelming. In the book, two children hurl a third from a rooftop. He falls wounded into a narrow space between two buildings, where Walker finds and rescues him. In the movie, two

police officers throw a teenager from a building to his death in a street crowded with people, and the incident leads to Murphy's struggle with himself over whether to identify the culprits. We conclude that none of appellant's claims of related events in the book and the movie raised a material issue as to their similarity.

None of appellant's other documentary evidence was sufficient to bar summary judgment. He argues that evidence he offered tended to show that lay observers considered the movie to be derived from the book and therefore raised a genuine issue as to their similarity. In particular, he claims that three newspaper articles demonstrated that reporters believed that the book and the film were related. Even assuming that the articles were relevant on the question of similarity, they had no probative value. One was the creation of a movie reviewer who later admitted that he had never read Walker's book. Both the others were accounts of a visit to Florida of the doctor who delivered Walker at birth, and mentioned Walker only in passing as the author of both the book and the film. Appellant contends that similarities between a review of his book and the analysis of his book prepared by the defendants' expert witness raise questions concerning similarities in the works themselves. But comparison of secondary or descriptive materials cannot prove substantial similarity under the copyright laws, cf. Davis, supra, 547 F. Supp. at 724-25, because the works themselves, not descriptions or impressions of them, are the real test for claims of infringement.

Appellant makes several claims of evidentiary error. He contends that the district court erred in considering the affidavit of a literary expert submitted by defendants, which analyzed the plot, themes, structure, characters

and pace of both works. District courts, appellant claims, routinely exclude such expert testimony when entertaining motions for summary judgment on the question of similarity.

The relevance, and hence the admissibility, of expert analysis on this issue depends on the standard for determining substantial similarity. We note that some confusion surrounds the standard to be applied. The formula most favored by courts, see Nimmer, supra, § 13.03[E][1], and often expressed in our circuit, see, e.g., Herbert Rosenthal Jewelry Corp. v. Honora Jewelry Co., 509 F.2d 64 (2d Cir. 1974); Ideal Toy Corp. v. Fab-Lu Ltd., 360 F.2d 1021 (2d Cir. 1966), is that substantial similarity should be judged by the spontaneous response of the ordinary lay observer. Taken literally, such a standard would altogether bar expert analysis and "dissection" of creative works. See Nicols, supra, 45 F.2d at 123 ("We hope that in this class of cases [expert] evidence may in the future be entirely excluded."). However, our opinion in Arnstein v. Porter, supra, indicated that such literalness is not required. That decision framed a two-part test for similarity by drawing a distinction between noninfringing "copying," on the one hand, which may be inferred from substantial similarities between the two works, and infringing "illicit copying," on the other, which demands that such similarities relate to protectible material. Under *Arnstein*,

> the trier of the facts must determine whether the similarities are sufficient to prove *copying*. On this issue, analysis (dissection) is relevant, and the testimony of experts may be received . . . . If copying is established, then only does there arise the second issue, that of *illicit copying* (unlawful appropriation).

> On that issue . . . the test is the response of the ordinary lay hearer; accordingly, on that issue, 'dissection' and expert testimony are irrelevant.

154 F.2d at 468 (emphasis added). See also Sid & Marty Krofft Television Productions v. McDonald's Corp., 562 F.2d 1157, 1164-65 (9th Cir. 1977); (expert testimony admissible to similarity of ideas or themes, but not as to similarities of expression, as to which the relevant test is "the observations and impressions of the average reasonable reader"); Davis v. United Artists, supra, 547 F. Supp. at 724 & n.8. Cf. Warner II, supra, 720 F.2d at 245 (refusing to decide whether surveys of public opinion are admissible on the question of similarity, but noting that substantial similarity is "not a concept familiar to the public at large" but rather "a term to be used in a courtroom" to strike a balance between the rights of authors and the freedom of other creators). We do not believe that Judge Edelstein's consideration of the affidavits was improper under *Arnstein*. Assuming arguendo that some of the "dissection" was improper, which we do not believe to have been the case, any error made in this regard was harmless since we find that no trier of fact could find the works substantially similar in their protectible aspects.

In addition, appellant asserts that the district court erred in refusing to consider the voiceover version of the film, and in refusing to compare the book and the film on the basis of appellant's list of purported similarities. We disagree. Fed. R. Evid. 1006, despite appellant's contentions, did not require that the voiceover version be admitted. The Rule is designed to deal with the problem of writings, recordings or photographs "which cannot conveniently be examined in court" by allowing them to be

presented in "chart [or] summary form," and does not apply to the movie, which could be viewed in its undistorted entirety by the use of standard projection equipment. Moreover, as the district court noted, in copyright infringement cases the works themselves supersede and control contrary descriptions of them. As the finally released version of the film was the best and most relevant evidence on substantial similarity, the judge was not required to consider the voiceover version in deciding the motion for summary judgment. In any event, the voiceover version adds nothing of significance to the briefs.

Appellant's argument that Judge Edelstein should have compared the book and the film on the basis of a list of similarities is similarly without merit. Courts customarily decide infringement cases, once access is decided, primarily through detailed viewing or reading of the works themselves. See, e.g., Warner II, supra; Hoehling, supra; Nichols, supra. While it might be an abuse of discretion to bar a plaintiff from using such lists in arguing on a summary judgment motion that similarities exist, appellant's objection has no force because Judge Edelstein had the alleged similarities called to his attention and focused on them carefully in his excellent opinion.

Finally, we need not decide whether Judge Edelstein erred in excluding from his consideration early drafts of the screenplay of the film. Generally, such early drafts might be useful to show that defendants had gained access to plaintiff's work, borrowed from it, and later made changes in order to conceal that borrowing. Although defendants conceded access in this case, early drafts could still have been evidence that some borrowing occurred. However, since we conclude as a matter of law

that, even assuming borrowing or copying, no substantial similarity exists between the protectible portions of the final versions of the works. any error in exclusion of the early drafts was harmless.

III.

In pressing his claim under the Lanham Act, Walker argued that appellees had attempted to confuse the public into believing that the film was derived from his book, in order to trade on the book's popularity. The district court's conclusion that the works were not substantially similar seriously undermines the theory that the film itself was designed to mislead viewers into associating it with Walker's book. See Warner II, supra, 720 F.2d at 246-47. Appellant also contends that the advertisement appellees placed in "Variety" in 1976 was itself an attempt to wrongfully "pass off" the film as a work created by Walker or derived from his work. The district court found, however, that no reasonable observer could infer from the advertisement that the film derived from "Fort Apache," or that the two works came from a common source. From our examination of the film and the "Variety" advertisement, which do not even mention Walker or his book, we agree. To bolster his argument that the public could not tell the book and the film apart, appellant offered the three newspaper articles described above. As already indicated, the articles were so unreliable and isolated as to deserve very little weight. The Lanham Act claim was therefore properly dismissed.

In addition, the district court was correct to dismiss appellant's pendent state law allegations of unfair competition and breach of a confidential relationship. As the

New York Supreme Court found in appellant's state court action, Walker's cause of action for unfair competition is preempted by the federal copyright laws to the extent it seeks protection against copying of Walker's book. 17 U.S.C. § 301(a); see Oboler v. Goldin, 714 F.2d 211 (2d Cir. 1983). We also agree that summary judgment was appropriate on Walker's claim that Heywood Gould breached a confidential or fiduciary relationship with Walker, because Walker failed to produce facts sufficient to show that Walker and Gould ever made any such agreement or that such a relationship otherwise existed between them.

Last of all, we conclude that the district court acted properly in dismissing Walker's state law claims on the merits after disposing of the federal claims. While federal courts, absent exceptional circumstances, should abstain from exercising pendent jurisdiction when federal claims in a case can be disposed of by summary judgment, see Kavit v. A.L. Stamm & Co., 491 F.2d 1176, 1180 (1974), we think that the circumstances here were exceptional. Many issues critical to appellant's state law claims, including their relationship to federal law, overlap considerably with the issues central to his claim of infringement. Moreover, the New York state courts have already considered appellant's state law causes of action, and found them to be "equivalent to" the federal claims. Considerations of "judicial economy, convenience and fairness to litigants," United Mine Workers v. Gibbs, 383 U.S. 715, 726 (1966), therefore made it proper for the district court to retain jurisdiction over the state law claims and to decide them on the merits.

The order granting summary judgment is affirmed.

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

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THOMAS WALKER,

Plaintiff,

-against-

TIME LIFE FILMS, INC., DAVID SUSKIND, GILL CHAMPION, MARTIN RICHARDS and HEYWOOD GOULD

Defendants.

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OPINION AND ORDER

83 Civ. 6755 (DNE)

APPEARANCES:

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of counsel for plaintiff.

PATTERSON, BELKNAP, WEBB & TYLER,
New York, New York, Eugene L. Girden,
Blair Axel & Dietrich Snell, of counsel
for defendants.

EDELSTEIN, DISTRICT JUDGE,

This is an action for copyright infringement, misappropriation, breach of a confidential and fiduciary relationship and unfair competiton, brought by plaintiff, Thomas Walker ("Walker"), author of the book Fort Apache. Plaintiff alleges that defendant, Time Life Films, Inc. ("Time Life"), and

various persons engaged by Time Life to write, produce and direct the film, "Fort Apache, The Bronx," illegally used plaintiff's original ideas and expression in making the film.

This court has jurisdiction over the copyright infringement claim ynder 28 U.S.C. section 1338 (a) and (b). Plaintiff also invokes this court's pendent jurisdiction over his state law claims of breach of confidence, misappropriation, unfair competition and deceptive trade practices. Defendants have moved for summary judgment on all claims. The motion is granted.

FACTUAL BACKGROUND

On June 25, 1980, Walker, a former police officer employed by the New York City Police Department, filed a complaint in New York State Supreme Court. Defendants in this action were Time Life, the producers of the

film "Fort Apache, the Bronx," David Suskind, Gill Champion, and Martin Richards and the screenwriter, Heywood Gould. The complaint alleged copyright infringement, unfair competition, breach of a fiduciary and confidential relationship and violation of the common law copyright. The state action was dismissed on the ground that, pursuant to 28 U.S.C. section 133, federal courts have original and exclusive jurisdiction of any civil action arising under any act of Congress relating to copyright. As to the balance of plaintiff's claims, the state court ruled that the state law claims of unfair competition and breach of a fiduciary and confidential relationship are simply "redundant and equivalent" to the copyright claim and were asserted for the purpose of avoiding federal preemption. Thus, the state court dismissed the claim in its entirety for lack of subhect matter jurisdiction.

On September 14, 1983, Walker filed a complaint in this court against the same defendants. The complaint alleges copyright infringement, pursuant to 17 U.S.C. section 301, violation of the Lanham Act, 15 U.S.C. section 1125a, unfair competition, deceptive trade practices and breach of a fiduciary and confidential relationship. The common law copyright action was not included in the federal court action. Defendants have moved for summary judgment.

The undisputed facts are as follows.[1] Walker was employed as a lieutenant and captain for the New York City Police Department assigned to the 41st precinct in the Bronx. The precinct is commonly known as Fort Apache

1. This information was provided for the court in the statements submitted by the parties pursuant to Rule 3(g) of the civil rules of the U.S. District Courts for the Southern and Eastern Districts of New York.

due to the high incidence of arson and other crimes within it. In 1976, the Thomas Y. Crowell Company published a book written by the plaintiff and entitled Fort Apache due to the high incidence of arson and other crimes within it. In 1976, the Thomas Y. Crowell Company published a book written by the plaintiff and entitled Fort Apache. On February 23, 1977, New York Magazine printed a cover story on plaintiff's book Fort Apache. Prior to the book's publication. defendant Heywood Gould entered into a contractual agreement with defendants Martin Richards and Gill Champion to write a screenplay based on police activities in the South Bronx. In March of 1974, a screenplay, entitled "Fort Apache, The Bronx," was filed by Gil Champion with the copyright office in the District of Columbia and given copyright # 90013. On February 6, 1981, Time Life released the motion picture "Fort Apache, The Bronx," based on the

screenplay by Heywood Gould.

The disputed issues of fact include the origin of the idea for defendants' film and the similarity of themes, characters and episodes in the book and the film. Defendants have conceded access to the unpublished manuscript for the purpose of this motion.

Walker asserts that in late 1971 or early 1972, Heywood Gould visited the 41st Precinct and identified himself as a newspaper reporter investigating the arson problem in the area. Walker claims he offered to show Gould a copy of his manuscript, provided Gould would not take notes. Gould allegedly agreed to this condition; however, Walker claims that when he returned later, he caught Gould taking notes. A few weeks after Gould's visit, Walker claims the manuscript disappeared from his locker in the station house.

The defendant contends that Gould never met Walker and did not visit the precinct until after publication of the book.

Defendants claim that the idea for the film originated in the late 1960's or early 1970's, when Mel Richards and Gill Champion saw a news report of a gruesome crime that occurred in the South Bronx. They began to research the background of the South Bronx with its escalating crime rate and made preparation for a dramatization of police activity in the area.

The book Fort Apache is an autobiographical account of Walker's experiences as a policeman patrolling the streets of the 41st precinct. The book's organization is topical. Chapters center on youth gang violence, poor officer morale and attacks on officers. Stylistically, the book reads more like a daily journal than a tightly interwoven and plotted dramatic account. The title Fort Apache is not Walker's independent creation; it has been commonly used to refer to the territory covered by the 41st

Precinct since the late 1960's.

Time Life's screen production is a dramatic fictional account of a police officer's romantic involvement with a drug-addicted nurse and the search for the killer of two 41st Precinct police officers. Although the film uses reports of some actual crimes that occurred in the South Bronx as source material, the film is predominantly a fictional work. The main character in the film, Murphy, unlike Walker, is a divorced disillusioned patrolman, who is contemptuous of authority.

Although plaintiff contends that a factual dispute exists as to whether the works are substantially similar, defendants contend that no reasonable observer could find substantial similarity between the two works. After viewing the final screen version of the film and the book as published in 1976, this court holds that no reasonable observer

could find substantial similarity. Any similarity that may exist is either trivial, abstract or non-protectible as a matter of law.

DISCUSSION

1. The Copyright Infringement Claim.

A. AMENABILITY TO SUMMARY JUDGMENT.

A series of copyright cases in this District have found noninfringement as a matter of law on a motion for summary judgment, either because the similar elements of the two works are non-copyrightable, or because no substantial similarity exists between the two works. E.g. Warner Bros. v. American Broadcasting Companies, 720 F.2d 231, 240 (2d Cir. 1983); Smith v. Weinstein, 578 F. Supp. 1297, 1302 (S.D.N.Y.), aff'd. mem., 738 F.2d 410 (2d Cir. 1984).

B. COURT'S EXAMINATION OF THE WORKS.

In determining copyright infringement, the works themselves supersede and control contrary allegations and conclusions, or descriptions of the works as contained in the pleadings. Davis v. United Artists, Inc., 547 F. Supp. 722, 724 (S.D.N.Y. 1982). The Court considers the works as they were presented to the public. Id. Plaintiff requests the court to compare the two works on the basis of lists of random similarities and on earlier scripts of the screenplay.[2]

2. This court has not considered plaintiff's voices over analysis of the film's first scenes. The plaintiff claims that Rule 1006 of the Federal Rules of Evidence authorizes the court to consider a shortened and edited version of the film. Plaintiff has misapplied Rule 1006 which only allows summaries and charts in abbreviated form for trial. The rule seeks to avoid distorging material from its general context. In determining substantial similarity, the court must only consider the works in their entirety and final form as presented to the public.

Affidavit of Samuel Rosenburg, Exhibit 1, November 16, 1984. This request is denied. Courts have routinely rejected requests to consider earlier drafts of the screenplay. Consideration of earlier versions of the screenplay is toc unreliable in determining substantial similarity. Huie v. National Broadcasting Company, 184 F. Supp. 199 (S.D.N.Y. 1960). See also Litchfield v. Spielberg, 736 F.2d 1352, 1356 (9th Cir. 1984), cert denied, 105 S. Ct. 1753 (1985) (rejection of list method of comparing works for substantial similarity, because it is "inherently subjective and unreliable.").

It is also unnecessary to discuss every alleged similarity in the two works; a brief discussion of the salient portions of plaintiff's argument is illustrative and sufficient. Zambito v. Paramount Pictures, No. 83-8409, slip op. at 10 (E.D.N.Y. July 22, 1985).

C. THE MERITS.

In a copyright infringement action, the plaintiff must prove copying by the defendant. See M. Nimmer, The Law of Copyright, 7809 sec paragraph 7 141 (1976). Evidence of access and substantial similarity are in themselves sufficient to create an inference of copying. Warner Bros. v. American Broadcasting Company, 654 F.2d 104, 207 (2d Cir. 1980).

I. NON-PROTECTIBLE MATERIAL.

Assuming, arguendo, that plaintiff can prove substantial similarity, copyright protection does not extend to historical or contemporary facts, material traceable to common sources or in the public domain, and scenes a faire. Many of the alleged similarities between Walker's book and the film fall into one of these categories.

a. FACTUAL INFORMATION.

Factual information is in the public domain and hence not protectible. See Werlin v. Reader's Digest Ass'n. Inc., 528 F. Supp. 451, 462 (S.D.N.Y. 1981); Rosemont Enterprises, Inc., v. Random House, Inc., 366 F.2d 303, 309 (2d Cir. 1966), cert. denied, 385 U.S. 1009 (1967). There is no copyright protection extended to the presentation of facts or in their selection. Hoehling v. Universal City Studios, Inc., 618 F.2d 972, 978 (2d Cir.), cert. denied, 449 U.S. 841 (1980).

Although creation of a non-fiction work, even a compilation of pure fact, entails originality, the police reports of the 41st precinct are not independent creations of Walker's imagination entitled to copyright protection. Harper and Row Publishers v. Nation Enterprises, 105 S. Ct. 2218, 2224 (1985). Walker concedes that the

that the events narrated in the book are true and that only the names were changed to respect the privacy of the individuals. T. Walker, Fort Apache, (1976) (copyright page), Deposition of T. Walker, July 17, 1980 at 10. The policemen's responses to the aftermath of crimes and attempted criminal acts are facts logged in police records, and are not protected by federal copyright statutes.[3] As the court concludes in Alexander v. Haley, 460 F. Supp. 40, 45 (S.D.N.Y. 1978), "where common sources exist for the alleged similarities, or the material that is similar is otherwise not original with the plaintiff, there is no infringement."

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3. The rationale underlying the scope of copyright protection afforded in the Second Circuit is best explained in Hoehling v. Universal City Studios, Inc., supra, 618 F.2d at 972. The Court reasoned that although the plots of the two works being compared by the courts were necessarily similar, there was no infringement because to forbid copying of historical facts and contemporary events would "interfere with the federal policy of allowing free access to copy whatever the federal patent and copyright laws leave in the public domain." Id. at 978.

In Smith v. Weinstein, supra, 578 F. Supp. at 1303, the film "Stir Crazy," was based on a prison rodeo, and thus did not infringe copyrightable elements of the book by the same name. The court concluded that no copying was possible because the rodeo was placed in the public domain by extensive news treatment. Similarly, in this case, the high rate of crime and violence in the burned-out blocks of the South Bronx received extensive news coverage in both print and on television. The subject matter was fair game for any artist. The crimes outlined by Walker were newsworthy events in the public domain and not entitled to copyright protection.

b. SCENES A FAIRE.

Similarly, scenes a faire--incidents, characters or settings which, as a practical matter, are indispensable or standard in the treatment of a given topic--are not protected.

Reyher v. Children's Television Workshop, 533 F.2d 87, 91 (2d Cir.), cert. denied 429 U.S. 980 (1976). In any account based on experiences in a poverty stricken, crime-ridden environment, depictions of bribery, prostitution, purse-snatching and neighborhood hostility to law enforcers are inevitable. Plaintiff contends that similar accounts in the film and book describe the disarming of threatening individuals, and the poor morale of disgruntled officers. See Affidavit of Samuel Rosenburg in Opposition to Defendants' Motion for Summary Juegment. These incidents are stock material for most police stories. Affidavit of George Stade, at 4-6 Plaintiff's claims of copying based on the portrayal of these events is without merit.

II. COPYRIGHTABLE MATERIAL.

Even as to the copyrightable elements,

the court finds that no reasonable observer could conclude that the book and the film are substantially similar.[4]

a. TEST FOR DETERMINING SUBSTANTIAL SIMILARITY.

The standard test for determining substantial similarity is whether an "average lay observer would recognize the alleged copyrighted work as having been appropriated from the original copyrighted work,: Ideal Toy Corp. v. Fab-Lu Ltd., 360 F.2d 1021, 1022 (2d Cir. 1966); however, this test has been qualified in this Circuit. In Warner Bros. v. American Broadcasting Company, supra, 720 F.2d at 245, the court stated that the test of substantial similarity for determining infringement is not a concept

4. Plaintiff has referred to issues which are appropriate for a jury to decide. However, it should be noted that plaintiff failed to demand a jury.

familiar to the public at large. Rather than using the reasonable observer test, substantial similarity is a "term to be used in a courtroom to strike a delicate balance between the protection to which authors are entitled under an act of Congress and the freedom that exists for all others to create their works outside the area protected against infringement." Id.

There arr two criteria for determining substantial similarity: proving "literal," or "word for word," similarity in certain instances of the work, or finding infringement of the work's "fundamental essence" or structure. Werlin v. Reader's Digest Ass'n. Inc., supra, 528 F. Supp. at 462.

b. ALLEGATIONS OF LITERAL SIMILARITY.

Plaintiff indirectly alleges both forms of similarity. In support of his claim of literal similarity, plaintiff contends that Murphy's statement in the film "better than the movies" copies Walker's statement

"better than a double feature at the R.K.O. Fordham." Plaintiff's Statement Pursuant to Rule 3(g), Exhibit 1. This claim of similarity is too vague and general. Further, plaintiff contends that Murphy's line in an earlier scripted version of the film, "we're here to keep the lid on a garbage can. . ." which was not included in the film, explicitly copies Walker's statement that "rumors. . . rattle through the area like a careening garbage can lid." T. Walker, Fort Apache at 67, (1976). However, the court need consider only the final version of the film as presented to the viewing public. Davis v. United Artists, Inc., supra, 547 F. Supp. at 724 n.9. Plaintiff also contends that Murphy's statement to an arrested man, you'll be out on the street in an hour," copies Walker's phrase "out in few minutes."[5] This and other alleged similarities are not

5. Plaintiff does not cite a page number, and the court cannot find the quote in the book.

material to the copied work and, even if they were material, they are too strained, far-fetched and abstract to be of consequence. Comparison of the film and book 5eveals no basis for this claim of literal or word-for-word similarity.

c. ALLEGATION OF SIMILARITY OF FUNDAMENTAL ESSENCE.

Plaintiff finds support for his substantial similarity claim from three newspaper articles which cite Walker as the source for the film: The Daily News, November]5,]98], "Romanticizing Real Life Stories", Lorenzo Carcaterra, The Pompano Ledger, Ed. Foley, and The Pompano Beach Rotary Bulletin, March 14, 1981. Because the subject matter of the Pompano newspaper articles concerns Doctor Goldenkrantz's[6] visit to the Pompano Beach Rotary Club,

6. Dr. Goldenkrantz is the doctor who delivered Walker at birth.

plaintiff's assertions lack merit. Further, Carcaterra, the reporter for The Daily News, has conceded that he did not read Walker's book. Affidavit of Thomas Walker, February 1, 1985. Plaintiff then contends that a group entitled the Union Patriotia Puertoriquenn also finds the book and film to be substantially similar. Affidavit of Thomas Walker, January 25,]985. However, the Second Circuit in Warner Bros. v. American Broadcasting Company, supra, 720 F.2d at 245, concluded that a few opinions cannot enlarge the scope of statutory protection enjoyed by a copyrighted property.

d. PROTECTION OF EXPRESSION OF IDEAS.

The similarity to be assessed must concern the expression of ideas, not simply the ideas themselves. 17 U.S.C. §102(b). To analyze similarity in expression, courts must compare the following elements of the

two works: the analysis and interpretation of events, the structuring of material and marshaling of facts, the choice of words, and the emphasis given to a particular development. Werlin v. Reader's Digest Ass'n. Inc., supra, 528 F. Supp. at 461-62.

Although the two works at issue are both based on police activities in the 41st precinct of the South Bronx, the structure of the two works and the authors' use of the factual information are clearly divergeny. Plaintiff's book has no central plot or organizing cheme; the book reads more like a policeman's diary of daily events than a unified literary creation with interdependent characters and stereotypes. In the later chapters, Walker organizes the patrolmen's experiences topically; chapters concentrate on youth gang violence, the officers' psychological instabilities, and attacks on the

station house. Unlike the book, the film's narrative is centered on Mur0hy's relationship with a drug-addicted nurse and the related murder of two fellow officers of the 41st precinct. All of the characters are interrelated; coincidentally, the nurse's drug dealer killed both the nurse and the psychopathic prostitute. Although both the film and book include the murder of two policemen, the book mentions the crime only briefly. Even if the producers of the film had given the murder similar treatment and emphasis, the event was based on the actual crime and thus not entitled to copyright protection. Alexander v. Haley, supra, 460 F. Supp. at 44-45. In contrast, the murder of the policemen in the film was a central motif. Many of the scenes in the film related to the murder, including the prostitute's subsequent attacks on unsuspecting male victims, the resulting round-up of innocent civilians and the neighborhood

attacks on the station house. Walker's work was unoriginal, as it failed to present a combination of ideas that could develop into a distinctive and protected creation by an interplay of characters and narratives. The plaintiff has not persuaded this court that a similarity of protected expression between the two works exists.

This court rejects plaintiff's claimed similarities between the prologue, the beginning of the book and the first scenes of the film. Affidavit of Thomas Walker in Opposition to Defendant's Motion for Summary Judgment, November 12, 1984. Walker's affidavit claims that the murder of two policemen, a futile chase scene, and a stolen wig, which all predominate in the book's beginning, are copied in the film. After viewing the film, this court cannot find substantial similarity. The film begins with the prostitute's brutal shooting

of two Fort Apache officers, a transvestite's threat to kill himself and the arresting officer's visit to the hospital. The only reference to a wig in the film is the transvestite's concern with his appearance. The murder alluded to in the novel was based on the actual shootings of Joseph Piagintini and Waverly Jones, a news event. Affidavit of Eugene Girden, Exhibit S at 20, October 19, 1984. No reasonable observer could possibly find substantial similarity of protected material between the beginning of the film and book.

e. TRIVIAL, IMMATERIAL AND INSUBSTANTIAL ALLEGATIONS.

Many of plaintiff's allegations of copying refer to incidents which are trivial, immaterial or insubstantial. For example, plaintiff contends that Murphy's recommendation to Corelli, his partner, to read either Dick Tracy or the Yellow Pages

illustrates that the filmmakers copied Sargeant Bartow's suggestion and Sargeqnt Grit, a fellow officer in the 41st precinct read The Blue Knight. See Exhibit 6 of Plaintiff's Memorandum in Opposition to Defendant's Motion for Summary Judgment. Further, Walker contends that the book's description of the lack of safe parking and the inadequate protection from vandals was copied in the film. These allegations, even if true, are trivial, insubstantial, and insufficient to prove substantial similarity of protectible material.

f. CHARACTER COMPARISON.

Plaintiff's expert, Samuel Rosenburg, has submitted an affidavit which claims that the film's leading characters are substantially similar to the protaganists in Walker's book. Exhibit 6 of Plaintiff's Memorandum in Opposition to Defendant's Motion for Summary

Judgment, November 12, 1984. Based on this affidavit, plaintiff contends that the Walker character is split into two characters in the film: Captain Connolly (Edward Asner) and Officer Murphy (Paul Newman). The plaintiff suggests that the dual role played by Walker "did not go unnoticed by the makers of the film." Id.[7] A comparative character analysis of the book and film illustrates both the absurdity of this argument and the lack of merit in the analogy. The characters in the film bear no similarity to the book's protaganists. The only identifiable similarity is their role as policemen in the same precinct. This Court takes judicial notice that members of the New York Police Department are often portrayed as Irish, smokers, drinkers, and third or fourth generation police officers. The assertion that defendants wrongfully appropriated any

7. This document does not contain page numbers.

expression of plaintiff's characters and ideas is rejected. See Giangrasso v. Central Broadcasting Company, Inc., 534 F. Supp. 472, 478 (E.D.N.Y. 1982).

The differences between Murphy and Walker are far greater than the abstract similarities asserted by plaintiff. Whereas Murphy is a disciplinarian who respects his commanding officers and is actively climbing the bureaucratic ladder. Walker is a new arrival and leaves the precinct at the conclusion of the book when he is transferred. In contrast, Murphy, an 18-year veteran of the 41st precinct, considers resigning; however, the end of the film implies that Murphy will stay in the precinct. Another divergence is the marital status of the two characters. Murphy is divorced, and his relationship with the emergency room nurse is a central element in the film's plot. In contrast, Walker is happily married.

There is almost no similarity between Walker and Captain Connolly (Edward Asner), aside from their positions of authority. Lt. Walker is relegated to patrolling the streets, and the Captain's responsibilities are based at the station house. In Plaintiff's Sur Reply Memorandum, he alleges that Lt. Walker and Captain Connolly (Asner) bear similar facial resemblences. This allegation is meritless because a finding of similarity by the ordinary reasonable observer is impossible; the reader of Walker's book is not presented with a clear picture of the author's physical appearance. The book traces the waning of Walker's naive idealism and, by the conclusion, he is realistically assessing the dim prospects for improving the crime-ridden area. In contrast, Captain Connolly's idealism is unaltered; this reflects the great differences that underlie the characters in

the film and the novel.

There are no characters in the book equivalent to Murphy, Connolly, Morgan, Finley,[8] the track star, the nurse, the drug dealer, the prostitute, the South Bronx People's Party and Corell's fiance. Affidavit of Eugene Girden, Exhibit 5.

These divergences clearly surpass and outweigh ant abstract similarities that may inevitably be found in works centered on New York City policemen patrolling a crime-ridden area.

In Durhan Industries Inc., v. Tomar Corp., supra, 630 F.2d at 913, the Second Circuit assessed the problems of the relative value to be given to some similarities: "as a matter of logic as well as law, the more numerous the differences

8. Morgan and Finley, police officers in the 41st precinct, threw a teenager off the roof of an apartment building.

between the two works, the less likely it is that they will create the same aesthetic impact so that one will appear to have been appropriated from the other." In determining infringement, if the points of dissimilarity not only exceed the remaining examples of similarity, but indicate either quantitatively or qualitatively, then there is no infringement. 3 M. Nimmer, supra, ¶ 13.03 [b], at 13-37. That is the case there. Accordingly, the copyright infringement claims is dismissed.

2. THE LANHAM ACT CLAIM.

Plaintiff's fourth cause of action alleges a violation of the Lanham Act, 15 U.S.C. 1125 (a), which prohibits false designation of origin or title. The Lanham Act provides: "Any person who shall. . . use in connection with any goods . . .false description or representation. . . shall

be liable to a civil action by any person who believes that he is or is likely to be damaged by the use of any such false description or representation." To prove a violation of the Lanham Act, two elements must be shown: (1) the infringed work must acquire a secondary meaning so that the public identifies it with the plaintiff and his work and (2) similar titles must spawn public confusion and the misconception that plaintiff either originated, sponsored, or is associated with defendant's work. In considering the second element, the Second Circuit in B and L Sales Associated v. H. Daroff and Sons, Inc., 421 F.2d 352, 353-54 (2d Cir.), cert. denied, 398 U.S. 952 (1970) concluded that although likelihood of confusion is frequently a fairly disputed issue of fact on which reasonable minds may differ, the issue is amenable to summary judgment in appropriate

cases. As with claims of copyright infringement, Courts retain the authority to monitor the outer limits of substantial similarity within which to determine whether there is a likelihood of confusion as to the source. Otherwise, the scope of protection a work enjoys would be expanded beyond what Congress prescribed. Warner Bros. v. American Broadcasting Companies, supra, 720 F.2d at 246.

Courts in the Second Circuit have determined that "absence of similarity leaves little basis for asserting a likelihood of confusion" in violation of the Lanham Act. Warner Bros. v. American Broadcasting Companyes, supra, 720 F.2d at 918). However, lack of substantial similarity is not a blanket reason for dismissal of a Lanham Act claim. If the second comer falsely represents his good as that of the trademark owner, a violation has occurred. A claim of 'passing off'

or 'palming off' may be established even if the goods are not confusingly similar. The wrong lies in the misrepresentation of a common source. Id. at 247.

Walker claims that Time Life's Variety advertisement misrepresents the film as deriving from the book Fort Apache. The advertisement however, simply announces the beginning of photography for the film. No. reasonable observer could infer that the film derived from the book based on the advertisement.

This court also rejects plaintiff's contention of public confusion; plaintiff presents three isolated newspaper articles which credit Walker as the author of both the book and the film. See supra, at 11-12. These examples alone do not illustrate popular misconception and are insufficient to prove that the public has come to identify the title with plaintiff

and his work. This is particularly true when the title refers to a geographical location that is not the plaintiff's independent creation. See Pre-Trial Order ¶5. Accordingly, Walker's Lanham Act claim is dismissed.

3. THE STATE LAW CLAIM.

A. JURISDICTION.

Dismissal of plaintiff's federal claims raises the question of whether the state law claims of misappropriation, unfair competition and trade practices, aNd breach of a confidential and fiduciary relationship should be dismissed without prejudice to their commencement in state court. This court has jurisdiction over the pendent claims under United Mine Worker's of America v. Gibb, 383 U.S. 717 (1966). The state court dismissed all the common law claims, finding that they are "simply redundant and equivalent" to

plaintiff's copyright claim and are based on the same facts. Walker v. Time Life Films, Inc., No. 8939/80, slip op. at 4 (N.Y. Sup. Ct. 1983). Although the Second Circuit has indicated that "... if the federal claims could be disposed of on summary judgment under Fed. R. Civ. P. 56, the court should refrain from exercising pendent jurisdiction, absent exceptional circumstances," Kavit v. A.L. Stamm and Co., 491 F.2d 1176, 1180 (2d Cir. 1974), in this particular fact situation, exceptional circumstances exist. The state court already had an opportunity to adjudicate the issue. Thus, by deciding the state law claims, this court is not usurping the state court's role in deciding the state law claims.

B. BREACH OF CONFIDENTIAL AND FIDUCIARY RELATIONSHIP.

Plaintiff's first cause of action alleges that defendant Heywood Gould, the screenwriter, abused a fiduciary or confidential relationship with plaintiff in obtaining access to the appropriated material. Actionable claims for breach of confidential and fiduciary relationships are centered on breach of an agreement between parties, or breach of trust they place in each other because of the nature of their relationship. Smith v. Weinstein, supra, 578 F. Supp. at 1307. Although plaintiff alleges that Heywood Gould, the screenwriter, read and took notes from an earlier manuscript, plaintiff has not submitted sufficient support showing that a confidential or fiduciary relationship existed between Walker and Gould. Furthermore, the cases cited by the plaintiff

do not support his claim of a confidential relationship. In Harper & Row Puboishers, Inc. v. Nation Enterprises, 501 F. Supp. 848, (S.D.N.Y. 1980), aff'd., 723 F.2d 195 (2d Cir. 1983), rev.d on other grounds, 105 S. Ct. 2218 (1985), the claims asserted were copyright infringement, conversion and interference with a contract; no claim for breach of a confidential relationship was presented. Further, the facts in Smith v. Weinstein, supra, 578 F. Supp. at 1297, are clearly distinguishable because Smith (the writer) and Weinstein's (the producer) relationship consisted of close personal and professional contracts, as Weinstein read Smith's scripts and directed them to film producers.

D. DECEPTIVE TRADE PRACTICES.

Plaintiff claims that Time Life confused and misled the trade and public and induced the mistaken belief that the film is associated with plaintiff's book. Complaint ¶ 40. Plaintiff contends that Time Life's advertisement in Variety on February 15, 1976 illustrates Time Life's attempt to amarket a similar product and steal profits. This assertion alone is insufficient for any reasonable trier of fact to find that the trade and public were confused and misled. Plaintiff himself admits that his book was well publicized even before the Variety advertisement appeared. See Affidavit of Thomas Walker, at 9. Walker even appeared on the cover of New York Magazine and on television and radio promotional spots. Moreover, the Variety advertisements make no reference to Walker's book; it simply states that principal photography was to

begin in May of 1976. Plaintiff's Memorandum in Opposition, Exhibit 1, November 16, 1984. Although plaintiff;s book and defendant's film refer to the same area of the South Bronx, plaintiff's use of the title Fort Apache is not sufficient to state a cause of action of unfair competition. Plaintiff concedes that the name Fort Apache predates his book, having been used since the late]960's to refer to the 41st precinct in the South Bronx. See Pretrial Order ¶5, Deposition of Thomas Walker, July 17, 1980 at 184. Plaintiff does not show that the defendant makes any allusion to being affiliated, connected or associated with the plaintiff, thus plaintiff's claim of unfair competition and deceptive trade practices are summarily dismissed.

Plaintiff's seventh cause of action asserts that defendant's film dissipated and destroyed the value of plaintiff's dramatic rights, irreparably and

irretrievably, by injuring and damaging his prospective profits. This claim approximates the misappropriation claim and is predicated on plaintiff's premises that there is substantial similarity between the two works. Because the misappropriation claim fails, there can be no relief for this claim. Further, upon this court's conclusion that there is no substantial similarity and only some similarity of nonprotectible and trivial material, this claim must be dismissed, because the works are fundamentally different. This precludes the plaintiff from arguing that the defendant sole the value of his future rights to a dramatic reproduction of Fort Apache. Pre-Trial Order ¶5.

CONCLUSION

Defendants' motion for summary judgment is granted in all respects. The clerk shall enter judgment in favor of defendants.

SO ORDERED.

Dated: New York, New York
August 14, 1985

_____
U.S.D.J.

PROOF OF SERVICE BY MAIL

I, the undersigned, say: I am and was at all times herein mentioned, a citizen of the United States and a resident of the County of Los Angeles, over the age of eighteen (19) years and not a party to the within action or proceedi that my business address is 8383 Wilshire Blvd., Suite 1018, Beverly Hills, CA 90211; that on April 7, 1986, I served the within Petition for Writ of Certiorari in said action or proceeding by depositing true copies thereof, enclosed in a sealed envelope with postage thereon fully prepaid, in the United States mail at Los Angele California addressed as follows:

Clerk, United States Supreme Court
1 First Street, N.E.
Washington, D.C. 20543

(original and 40 copies)

Patterson, Belknap, Webb & Tyler
Attorneys for Respondents
30 Rockefeller Plaza
New York, New York 10112
(212) 541-4000

I declare under penalty of perjury that the fore is true and correct. Executed April 7, 1986, at Beverly Hills, California.

Josie Thomas

Supreme Court, U.S.
FILED
MAY 9 1986
JOSEPH F. SPANIOL, JR.
CLERK

No. 85-1662

IN THE

Supreme Court of the United States

OCTOBER TERM, 1985

THOMAS WALKER,

Petitioner,

—v.—

TIME LIFE FILMS, INC., DAVID SUSSKIND, GILL CHAMPION, MARTIN RICHARDS and HEYWOOD GOULD,

Respondents.

BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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Response to Questions Presented

The case that petitioner asks this Court to consider has already been reviewed and rejected by one State and four federal judges. Petitioner continually modifies and complicates his arguments in a futile attempt to obfuscate the plain conclusion below that "no reasonable observer could find substantial similarity between the protectible elements of plaintiff's book and defendants' movie." 784 F.2d 44, 46 (2d Cir. 1986).

This practice continues on this Petition. None of these evasions, however, can obscure the fact that no difficult or novel legal issues have ever been presented by this garden-

variety copyright case, which was properly dismissed after comprehensive comparisons of petitioner's book and respondents' film. Since these comparisons were made—independently by the two courts below—on the basis of a settled legal standard, petitioner's unhappiness with the result raises no question worthy of review by this Court (except the frivolous nature of the Petition itself).

The Petition (Pet. 37-39),* for the first time in the long history of this case, argues that different standards should be applied to alleged copying and a claimed violation of the "right to prepare derivative works." This assertion has recently been characterized as "frivolous." *Litchfield* v. *Spielberg*, 736 F.2d 1352, 1357 (9th Cir. 1984), *cert. denied*, ____ U.S. ____, 105 S.Ct. 1753 (1985). Moreover, the question is an abstract one here because the finding below of the complete *dis*similarity between the book and the film precludes any conclusion of infringement regardless of whether the test is "substantial similarity," "based upon" or "derived from."

Petitioner also makes a series of arguments variously based on the Court's opinion in *Harper & Row, Publishers, Inc.* v. *Nation Enterprises*, ____ U.S. ____, 105 S.Ct. 2218 (1985). That case, however, involved conceded infringement of an unpublished manuscript and the invocation of the affirmative defense of fair use—a far cry from this case, where the Court of Appeals properly found that no reasonable trier of fact could infer any copying from petitioner's book.

In reaching its unanimous conclusion that the grant of summary judgment was proper, the Court of Appeals made a careful *de novo* review of the two works at issue and considered petitioner's numerous claims of similarity. Its amply supported conclusion that no "substantial similarity"

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* "Pet. ____" will be used hereinafter to refer to page numbers in the Petition for Writ of Certiorari.

could be found to any copyrightable material in petitioner's book settled the sole question in this case. Respondents therefore urge that certiorari be denied absent a clear showing that the Court of Appeals erred in affirming summary judgment or that its holding is in conflict with any of this Court or of another Court of Appeals.

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STATEMENT OF THE CASE

Petitioner's Statement of the Facts (Pet. 5-7) is only partially accurate. The Petition seeks review of the Court of Appeals' unanimous affirmance, 784 F.2d 44, of the District Court's grant of summary judgment dismissing petitioner's complaint for copyright and related claims.[1]

On February 6, 1981 respondents released a film entitled "Fort Apache, The Bronx," based on an original screenplay. The conception for the film arose in the late 1960's or early 1970's as a result of news reports of a world of violence in the 41st Precinct of the South Bronx, by then already commonly referred to as "Fort Apache." In writing the screenplay respondent Heywood Gould ("Gould") relied in part on conversations with South Bronx police officers as well as on news articles concerning the area.

Petitioner, a former police officer who served in the 41st Precinct for approximately one year in the early 1970's, published a book about his experiences in 1976. He alleged that in 1972 Gould visited the 41st Precinct and was given access to petitioner's manuscript draft of his book for approximately two hours or less. While petitioner has never claimed textual copying, he alleged that ideas from his manuscript were used by respondents in making their film. Although Gould, in a sworn statement, set forth that he has never met or spoken with petitioner, never saw his manuscript or the book and did not visit the 41st Precinct until 1979, respondents conceded access to petitioner's manuscript for *purposes of the summary judgment motion only.* The District Court, in a 26-page opinion, granted summary judgment after a first-hand comparison

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1 Prior to his federal action, petitioner filed a complaint—nearly identical to the complaint herein—in New York State court alleging copyright and related common law claims. The State court held that all the common law claims duplicated and were preempted by the copyright claim, which had to be prosecuted in federal court. Shortly after entry of judgment dismissing the State court action in its entirety, the instant complaint was filed.

of petitioner's book and respondents' film. Petitioner had never demanded a jury trial.

On appeal, the Court of Appeals stated that "[e]ach of the panel members has read the book and viewed the film." 784 F.2d at 49. Following this *de novo* review of the works themselves, *see Litchfield* v. *Spielberg*, 736 F.2d at 1356, the Court in an 18-page opinion concluded as a matter of law that little of the material in petitioner's book is sufficiently novel and unique in expression to merit copyright protection and that none of the remainder is "substantially similar" to anything in respondents' film.[2]

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2 The Court of Appeals found similarity at only the most general of levels and stated "the notion of telling a police story that takes place [in the South Bronx] cannot be copyrightable." 784 F.2d at 50. After conscientiously reviewing petitioner's numerous claimed similarities, the Court concluded that they "either fail to materialize or prove entirely insubstantial." *Id.*

ARGUMENT

POINT I

PETITIONER'S BELATED INCANTATION OF THE "RIGHT TO PREPARE DERIVATIVE WORKS" DOES NOT ALTER THE PROPRIETY OF THE DECISION BELOW

Running variously through the Petition are *non sequitur* references to the right "to prepare derivative works based upon the copyrighted work," 17 U.S.C. § 106(2), and the right "to reproduce the copyrighted work," 17 U.S.C. § 106(1). The Petition asserts conclusorily that differences between these provisions—although never raised in any of the prior hearings this case has received—somehow afford petitioner rights which were ignored below. To the extent these provisions differ, however, the distinctions have nothing to do with petitioner's absolute and fatal failure to establish "substantial similarity."

A "derivative work" is defined as

> "a work based upon one or more pre-existing works such as a . . . dramatization, fictionalization, motion picture version . . . abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. . . ."

17 U.S.C. § 101. A work is not derivative unless it has "substantially copied" from a prior work. *Reyher* v. *Children's Television Workshop*, 533 F.2d 87, 90 (2d Cir.), *cert. denied*, 429 U.S. 980 (1976). *See* A. Latman, *The Copyright Law* at 175 (5th ed. 1979). In order to violate an author's rights under 17 U.S.C. § 106(2), the infringing work must incorporate some portion of the copyrighted work. Notes to the Committee on

the Judiciary, House Report No. 94-1476, *reprinted in* 17 U.S.C. § 106(2) (1982).[3]

> If the allegedly infringing work
>
> "does not incorporate sufficient of the preexisting [copyrighted] work as to constitute an infringement of either the reproduction right, or of the performance right, then it likewise will not infringe the right to make derivative works because no derivative work will have resulted."

2 M. Nimmer, *Nimmer on Copyright* § 8.09 at 8-110.2 (footnotes omitted). *See Midway Mfg. Co.* v. *Artic International, Inc.*, 547 F. Supp. 999, 1013-14 (N.D. Ill. 1982), *aff'd*, 704 F.2d 1009 (7th Cir.), *cert. denied*, 464 U.S. 823 (1983). In short, the unauthorized incorporation of any substantial part of a protected work in a "derivative work" is simple copyright infringement.[4] *See, e.g., Douglas International Corp.* v. *Baker*, 335 F. Supp. 282 (S.D.N.Y. 1971). *See, also, Cortner* v. *Israel*, 732 F.2d 267 (2d Cir. 1984).

In order to be a "derivative work" the borrowed material must relate to the *original expression* given to ideas in the copyrighted work and not merely to ideas or facts or true

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3 In cases, like this, *not* involving the interplay of separate copyrights on an "underlying work" and a "derivative work," *compare, e.g., Rohauer v. Killiam Shows, Inc.*, 551 F.2d 484 (2d Cir.), *cert. denied*, 431 U.S. 949 (1977), there are few distinctions between copying and violation of the right to prepare derivative works. Indeed, since a derivative work must be closely "based upon" a pre-existing work, which would necessarily involve some copying of substance, it has been said that the "right 'to prepare derivative works . . .' may be thought to be completely superfluous. . . ." 2 *Nimmer* § 8.09 at 8-110.2 (1985).

4 It is not surprising that whenever § 106(2) or its predecessor right under the 1909 Copyright Act is invoked, the cases are also treated, in the alternative, as claims of infringing copying. *See, e.g., Litchfield* v. *Spielberg*, 736 F.2d 1352 (9th Cir. 1984), *cert. denied*, ____ U.S. ____, 105 S.Ct. 1753 (1985); *Benny* v. *Loew's, Inc.*, 239 F.2d 532 (9th Cir. 1956), *aff'd*, 356 U.S. 43 (1958).

events. *Reyher* v. *Children's Television Workshop*, 533 F.2d at 90. *See* P. Goldstein, *Derivative Rights and Derivative Works in Copyright*, 30 J. Copr. Soc'y, 209, 231, Item 442 (1983). Thus, the findings below of similarity only as to the uncopyrightable *idea* of setting a police drama in the Bronx, or the inevitable elements of drugs, crime, garbage or prostitutes in such a milieu, are dispositive of the claim that respondents' film was "derived from" or "based upon" any original and protectible aspects of petitioner's book.

Petitioner's strenuous efforts to characterize respondents' film as a "derivative work" are futile because his argument that "substantial similarity" need not be shown to establish infringement under 17 U.S.C. § 106(2) is simply wrong. *Litchfield* v. *Spielberg*, 736 F.2d at 1357-58; *Harry Fox Agency, Inc.* v. *Mills Music, Inc.*, 543 F. Supp. 844, 849 (S.D.N.Y. 1982), *rev'd on other grnds*, 720 F.2d 733 (2d Cir. 1983), *rev'd on other grnds sub nom.*, *Mills Music, Inc.* v. *Snyder*, ____ U.S. ____, 105 S.Ct. 638, *aff'd without op.*, 779 F.2d 35 (2d Cir. 1985); *United States* v. *Taxe*, 540 F.2d 961, 965 n.2 (9th Cir. 1976), *cert. denied*, 429 U.S. 1040 (1977). *See also* 2 *Nimmer* § 8.09[B][3] & nn. 22-24. Indeed, it has been stated that the "novel proposition" that § 106(2) does not require substantial similarity and has "altered the protection afforded by the law of copyright [is] frivolous." *Litchfield* v. *Spielberg*, 736 F.2d at 1357. *See Berkic* v. *Crichton*, 761 F.2d 1289, 1291 n.1 (9th Cir.), *cert. denied*, ____ U.S. ____, 106 S.Ct. 85 (1985).

The implication (Pet. 33) that the Court of Appeals' decision conflicts with *WGN Continental Broadcasting Co.* v. *United Video, Inc.*, 693 F.2d 622 (7th Cir. 1982), is plainly incorrect. *WGN* held that copyright protection for a broadcast program could extend to certain "teletext" signals encoded into the program's tape. This was the only novel question in *WGN*, and Judge Posner stated that upon its resolution the case could be treated as one of simple copyright "infringement under familiar principles." 693 F.2d at 625. Both *WGN* and *Gilliam* v.

American Broadcasting Cos., 538 F.2d 14 (2d Cir. 1976), also relied on by petitioner, involved the partial editing of copyrighted television programs to create literal copies of large portions of the protected works. It was not disputed that the infringing works in those cases, being edited copies of the originals, were "substantially similar"—indeed, *identical*—to extensive parts of the copyrighted works. These cases lend no support whatsoever to petitioner's argument that a claim of deletion from a copyrighted work eliminates or alters a plaintiff's burden of proving "substantial similarity" to the allegedly copied portions of the protected work.[5]

In the instant case, petitioner has never claimed that any portion of respondents' film involves literal copying from his book. Thus, he must still prove substantial similarity to copyrightable material in his work. *See Berkic* v. *Crichton*, 761 F.2d at 1291 n.1. Here, two federal courts have made independent comparisons of the book and the film and have concluded that no reasonable trier of fact could find substantial similarity to any protectible material in petitioner's book.

POINT II

THE COURT'S DECISION IN *HARPER & ROW* RAISES NO ISSUES REQUIRING GRANT OF THE WRIT IN THIS CASE

The Petition refers to *Harper & Row, Publishers, Inc.* v. *Nation Enterprises* as support for a series of miscellaneous points. The distinctions between that case and this, however, are so numerous and fundamental that perhaps *Harper & Row's* only relevance here is its reaffirmance of the distinction

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5 Nor was there any question in *WGN* or *Gilliam* that the plaintiffs' works were both copyrightable and copyrighted. Here, petitioner failed to show that whatever in the book and film may have been similar related to anything other than uncopyrightable general ideas and facts. 784 F.2d at 50.

between copyrightable original expression and uncopyrightable facts and ideas. 105 S.Ct. at 2229-31. It was largely on the basis of this distinction that this case was properly dismissed.

As a threshold matter, *Harper & Row* is inapplicable because the respondent therein conceded substantial *verbatim* copying which it further admitted would constitute infringement unless excused as "fair use" under § 107 of the Copyright Act of 1976. 105 S.Ct. at 2224. Thus the case dealt with a statutory defense to admitted infringement and, unlike this case, there was no dispute as to "substantial similarity." Moreover, it was not questioned that the verbatim quotes from President Ford's memoirs qualitatively embodied the author's "distinctive expression" and the "heart" of his original work. 105 S.Ct. at 2233.

The Court in *Harper & Row* concluded that a "key" factor in assessing claimed "fair use" was the fact that the infringement involved the publication of an *unpublished* manuscript in a deliberate attempt to "scoop" its first appearance elsewhere as planned by the author and his assignees. 105 S.Ct. at 2221, 2227. Central to *Harper & Row* was the Court's determination to protect the "right of first publication" under 17 U.S.C. § 106(3) that attaches to an *unpublished* work and is "inherently different from other § 106 rights. . . ." 105 S.Ct. at 2227.

Moreover, unlike *Harper & Row*, this case has never involved a claim of "fair use," or any other defense, in the face of admitted copying. On the contrary, infringement has always been denied here and the central issue below was "substantial similarity." Unlike the significant legal issues relating to the fair use defense in *Harper & Row*, the Second Circuit's opinion here is not a candidate for review by this Court because it was based on settled legal principles that led to the inevitable conclusion that there were no triable issues of fact on the question of infringement.

Finally, *Harper & Row* hardly requires a grant of the Writ merely because the Petition (p.32) quotes the Court's reference

to the issue of how "uncopyrightable elements combine with the author's original contributions to form protected expression." 105 S.Ct. at 2224. That issue need not be reached here because the Court of Appeals properly found that whatever similarities may exist between the two works relate solely to the most general level of uncopyrightable ideas and facts. The close analysis given the book and the film below demonstrated that uncopyrightable "stock" scenes and true events were given "radically" different treatments in their expression, structure and characterization in the two works. 784 F.2d at 49-51. Whatever did constitute petitioner's "original contribution" simply does not appear in any form in the film.[6] As the Second Circuit concluded, "the claimed similarities either fail to materialize or prove entirely insubstantial." 784 F.2d at 50.

POINT III

PETITIONER'S CLAIMED "COMMON LAW COPYRIGHT" WAS ABOLISHED BY THE 1976 COPYRIGHT ACT AND WAS, IN ANY EVENT, EXTINGUISHED UPON PUBLICATION OF HIS BOOK

Petitioner makes various references to "common law copyright" and suggests that since his complaint alleged that respondents had access to his manuscript prior to its publication in 1976, he has rights additional to those recognized by the Copyright Act of 1976.

This confused reading of the statutory scheme gains petitioner nothing. As shown above, petitioner published his book in 1976 while respondents did not release their film to the public until February 1981. Whatever common law rights

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6 This contrasts sharply with *Harper & Row*, where the defendants' own publicity for their verbatim use of the unpublished manuscript proved that they had "quoted these passages precisely because they qualitatively embodied Ford's distinctive expression." 105 S.Ct. at 2233.

petitioner assertedly had could not have arisen until the latter date, the time of respondents' first act of publication and the earliest conceivable point at which respondents could have interfered with any State law right.[7] *Estate of Hemingway* v. *Random House, Inc.*, 53 Misc.2d 462, 464, 279 N.Y.S.2d 51, 55 (Sup. Ct. N.Y. Co.), *aff'd*, 29 A.D.2d 633, 285 N.Y.S.2d 568 (1st Dep't 1967), *aff'd*, 23 N.Y.2d 341, 345-46, 296 N.Y.S.2d 771, 776 (1968). *See American Vitagraph, Inc.* v. *Levy*, 659 F.2d 1023 (9th Cir. 1981). However, the Copyright Act of 1976 expressly preempted and abolished all equivalent common law copyright claims arising after January 1, 1978. 17 U.S.C. §§ 301(a), (b)(2). *See Sears, Roebuck & Co.* v. *Stiffel Co.*, 376 U.S. 225 (1964); *Compco Corp.* v. *Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964).

Even assuming, *arguendo*, that petitioner had had some common law copyright claim that arose prior to January 1, 1978, that right would apply only to his *unpublished* manuscript. Copyright Act of 1909, 17 U.S.C. § 2. Any such right, however, was "extinguished immediately upon publication of the work" by petitioner in 1976. *Estate of Hemingway* v. *Random House, Inc.*, 23 N.Y.2d 341, 346 n.1, 296 N.Y.S.2d 771, 776 n.1 (1968). As to any alleged infringement thereafter, including the publication of respondents' film in 1981, petitioner must rely exclusively on federal statutory copyright and his suggestion otherwise is meritless.

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7 Petitioner confuses an erroneously claimed legal right with a purely evidentiary issue by insisting there is relevance in the fact that he claims copying from his draft manuscripts as well as from his finished book. (Pet. at 30). Because the sole test of infringement is substantial similarity of the works in their final form as displayed to the public, *Davis* v. *United Artists, Inc.*, 547 F. Supp. 722, 724 (S.D.N.Y. 1982), petitioner's early drafts were rendered irrelevant by respondents' concession of access *for purposes of the summary judgment motion only*. The Court of Appeals properly concluded that, *even assuming*, both access and borrowing from petitioner's early drafts, since no reasonable observer could find substantial similarity between the final works as published, there was no need to consider the drafts even as evidence of preliminary borrowing. 784 F.2d at 52.

POINT IV

THIS CASE IMPLICATES NO CONFLICT IN THE CASE LAW

As shown above (pp. 5-6), petitioner's argument that a conflict among the Circuits exists regarding "derivative works" is meritless. Regardless of whether the issue is "copying" or a claimed "derivative work" "based upon" another work, the courts uniformly require "substantial similarity" for a conclusion of infringement.

The Petition also argues (Pet. 35-36) that there is conflict in the case law as to the procedures to be used in determining "substantial similarity." It may be true that in individual cases difficulties can arise in applying the "idea-expression dichotomy," *Sid & Marty Krofft Television Productions, Inc.* v. *McDonald's Corp.*, 562 F.2d 1157, 1165 (9th Cir. 1977), which permits expert testimony as to similarity of ideas or themes but not as to similarity of expression, which is to be tested by the impressions of the "ordinary lay observer." *See Arnstein* v. *Porter*, 154 F.2d 464, 468-69 (2d Cir. 1946), *cert. denied*, 330 U.S. 851 (1947); *Davis* v. *United Artists, Inc.*, 547 F. Supp. 722, 724 & n.8 (S.D.N.Y. 1982). Even assuming such difficulties, however, the Petition has failed to show any clear conflict among the Circuits.[8] *See* N. Boorstyn, II *Copyright Law Journal* 86, 87 (April 1986) ("*Arnstein* test for substantial similarity is virtually a mirror-image of the Ninth Circuit's extrinsic-intrinsic test set forth in *Krofft*. . . .")

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8 In any event, even if there were some conflict, the issue would not be reached in this case because the admission of expert testimony below for limited purposes would be at most harmless error in light of the finding "that no trier of fact could find the works substantially similar in their protectible aspects." 784 F.2d at 52. Petitioner's implied suggestion that there was error in the admission of expert testimony is curious in the face of his own submission of such testimony which was in fact considered below. Indeed, the Petition itself in an "addendum" improperly submits further "expert" testimony—in a new form not seen heretofore by respondents.

Finally, by his own description of *SAS Institute, Inc.* v. *S&H Computer Systems, Inc.*, 605 F. Supp. 816 (M.D. Tenn. 1985) and *Atari, Inc.* v. *North American Philips Consumer Electronics Corp.*, 672 F.2d 607 (7th Cir.), *cert. denied*, 459 U.S. 880 (1982), as cases questioning the "ordinary lay observer" test for "technical" computer cases, petitioner distinguishes those cases from this case, which involved traditional literary forms obviously proper for comparison by the ordinary observer.

CONCLUSION

The Court should deny the Petition for Certiorari.

Respectfully submitted,

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